

No. 9327

United States  
Circuit Court of Appeals

For the Ninth Circuit *b*

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PAYNE FURNACE & SUPPLY COMPANY, INC.,  
a corporation,

*Appellant,*

vs.

WILLIAMS-WALLACE COMPANY,  
a corporation,

*Appellee.*

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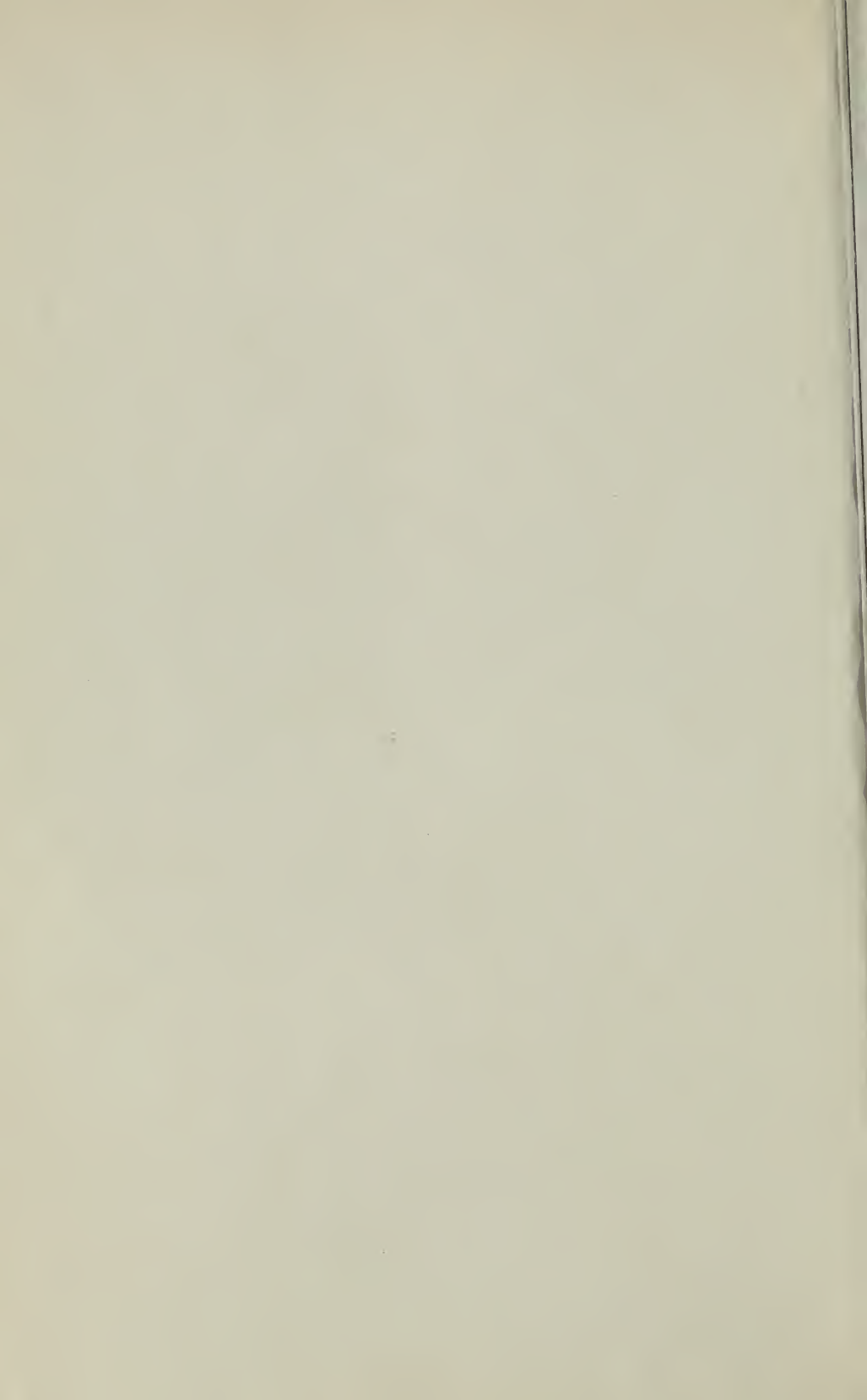
**BRIEF FOR APPELLEE**  
**IN REPLY TO APPELLANT'S REVISED BRIEF**

**FILED**

JUL 11 1940

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**BRIEF FOR APPELLEE**  
**IN REPLY TO APPELLANT'S REVISED BRIEF**

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**STATEMENT OF THE CASE.**

This is an appeal from a decree entered by Judge Louderback in the Northern District of California, sustaining the validity of Letters Patent No. 2,013,193, owned by appellee, holding it infringed by appellant, and holding that appellant had neither a shopright, an implied license nor an express license under the patent (I. 62).<sup>\*</sup> Infringement was admitted, as appellant's con-

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<sup>\*</sup>For uniformity, the Roman numeral refers to the volume of the Record and is followed by the page number.

NOTE: Emphasis in quotations ours, unless otherwise noted.

struction is a "Chinese copy" of the patent (I. 82). The jurisdiction of the court below and of this Court is unquestioned. The only question left for this Court is an examination of the findings of the trial court on validity of the patent, as appellant has abandoned the alleged shopright defense.

After carefully checking and rereading appellant's brief several times, the only trial court finding found mentioned is No. 7 (I. 51) and conclusion of law No. 1 (I. 62). In view of Rule 20 of this Court plus its admonition in *Simon v. Davidson Brick Co.* 106 F. (2d) 518, 521 (see appendix p. x) and even in this very case on June 4, 1940, we believe the court is justified in disregarding those arguments in appellant's brief directed to nine unnamed trial court findings. The burden of answering appellant's new brief has been immeasurably increased by its argument of the case at large and its complete disregard of the trial court's findings. Our familiarity with the facts has made it possible for us in most cases to identify the respective findings we think are being questioned by appellant's arguments. These we have classified so far as possible in the Summary of Argument.

#### **Important Factual Background.**

The patent (III. 637) was issued to cover an important new development made in the metal flue pipes by Jacob A. Stadtfeld. The patented device has turned out to be of very real importance in its field and is one of only two metal flue pipes which are approved for installation by city and county building authorities

(II. 554). It is being marketed on a nation-wide scale and is steadily displacing other kinds of flue pipe. For some time prior to the patented invention there was no approved metal flue pipe. Those that had been used earlier had failed and were forbidden by law (II. 372). The problem had been acute for a number of years (II. 574). Stadtfeld's search for a successful flue pipe began about 1920 (II. 501) and continued practically constantly up to the date of his discovery in the fall of 1932 of the invention covered by the patent in suit (Fdg. 24). Others, including appellant, were also searching to discover the correct construction of a metal flue pipe for venting gas burning appliances but none succeeded. There was a long felt want (II. 574). Nothing in the prior art was either acceptable to the authorities or efficient as a flue pipe. Appellant's have not been able to change from the patented construction to any of the prior art constructions.

Stadtfeld's experience was that of the typical inventor,—a poor man who had spent all he could get together to carry on further experiments. Then when the goal was achieved he was penniless and at the mercy of anyone who wanted to take unfair advantage of him. Appellant attempted this but, fortunately, without success.

Stadtfeld's first attempt at merchandising his newly discovered flue pipe was with Ace Sheet Metal Works and was short lived (II. 537). His second attempt was with Dutton, who did business as the Standard Asbestos Co. Stadtfeld turned the invention over to Dutton and went to work for him on a salary (Fdg. 26). Dutton was not

equipped to make the pipe economically and after a time told Stadtfeld he would turn over the invention to anyone who would buy up his \$3500 of stock (Fdg. 29). Stadtfeld's third attempt was with appellant, who hired Stadtfeld on a salary with the understanding "that something would be worked out if a patent were secured" (Fdg. 41). Appellant also knew that Dutton's stock had to be taken over to get title to the invention (Fdgs. 31, 32). In spite of the advice of appellant's patent attorney that there was a possibility of securing a patent on the Stadtfeld flue pipe, appellant refused to spend the money to do it (Fdgs. 37, 39).

"Stadtfeld was penniless and had exhausted his funds during many years of experimenting with different flue pipes leading up to the perfection of the flue pipe of the patent in suit, and was not in a position to finance an application for patent when Payne (appellant) decided to ignore the invention and not take over Dutton's rights, in spite of the fact that Payne's attorney, Mr. Connor, had indicated that a limited patent might be obtained" (Fdg. 42, I. 58). "Stadtfeld for a time protested to defendant (appellant) but to no avail" (Fdg. 43, I. 58). He had visions of losing the highly successful product of his years of experimenting and personal sacrifices.

"Stadtfeld, knowing that Payne (appellant) had not taken over all of Mr. Dutton's stock so as to be entitled to Dutton's rights in the invention and the trade mark 'Metalbestos', and knowing that Payne did not intend to secure a patent on his invention, resigned from Payne's employ on September 1, 1934, and returned to San Fran-

cisco to see if he could interest some other manufacturer in Metalbestos” (Fdg. 44, I. 58).

Stadtfeld’s fourth and successful attempt at realizing on his invention was with appellee. “Early in September, 1934, Stadtfeld called on Mr. Wallace, manager of plaintiff (appellee) company, and told him that Payne (appellant) had decided not to acquire the rights in the invention and trade mark ‘Metalbestos’ from Mr. Dutton, and that these rights could be obtained from Mr. Dutton by plaintiff company” (Fdg. 45, I. 59). Appellee acquired title from Dutton and took steps to protect the valuable Stadtfeld invention (Fdgs. 47-49).

When appellee put its resources behind Stadtfeld and his invention, appellant realized it was no longer dealing with a helpless, penniless inventor but with a formidable rival who had the money to give the invention the protection it deserved (II. 382). *Appellant’s interest in the patenting of the invention then suddenly revived.* In the winter of 1934 appellant’s manager came to appellee with “a proposal to purchase the rights plaintiff (appellee) had secured from Dutton \* \* \*, but the offer made at this time was turned down by plaintiff. At this conference Mr. Payne was advised by plaintiff that as soon as the patent was secured, plaintiff would expect defendant (appellant) to cease manufacture and sale of the pipe in suit” (Fdg. 51, I. 60). In the spring of 1935 Mr. Payne “again visited plaintiff (appellee) \* \* \* and *admitted he ‘slipped up on getting the rights from Mr. Dutton’* and again proposed that plaintiff sell these rights to defendant (appellant). This offer was turned down” (Fdg. 55, I. 61). The patent

issued September 3, 1935, and appellant was given written notice of its infringement on September 10, 1935. Nevertheless, appellant continued to infringe and this suit became necessary.

Caught redhanded in its infringement, the defenses argued by appellant are solely of a technical nature.

The alleged disclaimer defense depends upon erroneous constructions appellant has seen fit to place on the disclaimer statutes. On these erroneous unsupported premises it has built its house of cards. When the controlling law is examined and we see how the courts have interpreted the disclaimer statutes, appellant's house of cards collapses because its premises are false. The soundness of the trial court's disclaimer findings 7, 8 and 9 is unassailable.

The other technical defense asserted is that the prior art taught the invention. Appellant devotes very little space to this alleged defense because, *having imitated the invention and not the prior art, there is nothing effective it can say*. Its acts speak louder than any words it might utter. Appellant combed the prior art, but failed to discover there any disclosure of the invention. *It has no answer to the fact that it cannot successfully adopt any of the prior art devices in lieu of the invention in suit, or to the fact that the prior art devices are not acceptable under any building ordinances*. The fact is that they are not like the invention in suit and so the trial court correctly found (Fdgs. 11, 12, 13, 14, 15, 16 and 22). *The case presents an aggravated instance of a ruthless manufacturer first trying to do the inventor out of his inven-*



*competitor, of trying to buy the invention, and then, when refused, of stubbornly insisting upon appropriating the highly meritorious patented invention on the possible chance of an inadvertent decision.*

We respectfully submit that there is no new point developed in appellant's brief which was not fully considered by the trial court before entering its findings. We welcome the opportunity of analyzing appellant's erroneous arguments. Their inherent unsoundness and lack of merit is easily demonstrated.

#### **TRIAL COURT'S FINDINGS SUMMARIZED.**

An exceptionally complete set of findings were made by the trial court in deciding this case (I. 50). These meet and dispose specifically of each and every point urged in appellant's brief and may be summarized as follows:

1. The flue pipe art is an old art (I. 52) and Stadtfeld's invention was substantial and important and solved a problem of long standing in that art (I. 53).

2. Stadtfeld was the first in the art to create a flue pipe structure containing the combination defined in each of the three claims, which was a substantial and meritorious advance over anything in the prior art and required inventive genius to produce (I. 51).

3. One of the principal merits of the invention is its simplicity. It was an arrangement of old elements which produced a new result (I. 53).

4. *When* it appeared to plaintiff that through inadvertence, accident or mistake the language of the claims

was of undue breadth and permitted an interpretation broader than was *intended*, proper qualifying disclaimers were filed. The effect of these was to modify the three elements of each claim *without adding new elements*. Each modifying limitation was taken directly from the specification of the patent as originally filed. Each claim, after disclaimer, as before disclaimer, had only three elements (I. 51).

5. Appellant's flue pipe is admitted to come within these claims, therefore infringement is not an issue (I. 50, 51).

6. The claims, either before or after disclaimer, are not like any claim (e.g. claims 3, 4, 5 and 8) abandoned during prosecution of the application (I. 51).

7. The claims, after disclaimer, as before, cover a single section of pipe and not a plurality of sections (I. 51).

8. The claims, after disclaimer, as before, do not call for an aggregation, but are for a patentable combination (I. 54).

9. Each of the prior art patents fails to disclose one or more of the elements of the claims or any equivalent thereof, and fails to show any prior invention, knowledge, use, or patenting (I. 52) of the Stadtfeld invention.

10. The alleged prior use by Baker fails to disclose one or more of the elements of the claims or any equivalent thereof, and fails to show any prior invention, knowledge, or use of the Stadtfeld invention (I. 52).

11. None of the prior art structures shown in any of the defendant's exhibits contains or discloses a flue pipe

made in relatively short sections, each section being composed of an inner and outer tube separated and supported concentrically by layers of insulating material and having the adjacent ends of these pipes with male and female construction with the male end of the inner tube pointing downwardly and the male end of the outer tube pointing upwardly and having the tube slidable so that when a plurality of sections are joined together, the inner joined sections are supported independently of the outer joined sections (I. 52).

These express the substance of findings 7, 8, 9, 11, 12, 13, 14, 15, 16 and 22 which are controlling upon this appeal unless the court finds them "clearly erroneous" (Rule 52a of the Rules of Civil Procedure). Each of the findings is supported by the overwhelming evidence and they may not be disregarded. Except as to Finding No. 7 appellant does not suggest any claim of error in specific findings.

#### THE PATENTED INVENTION.

For the convenience of the court, an illustrative chart based on Plaintiff's Exhibit 18 (III. 672) is mounted on the inside back cover to remain unfolded and readily available for reference during the reading of this brief. If consulted at this time, reading from bottom to top, the significant features of the invention and its operating environment can be readily seen.

The patent (III. 636) shows in Fig. 1 three sections of the flue pipe with the parts broken away, where the two lower sections are joined, to show the nature of the joint.

Each sectional unit employs an inner tube 1 which is "made preferably from aluminum or other suitable material". Around tube 1 is positioned a number of windings of layers 2 "of heat insulating material which has a plurality of air cells 3 running longitudinally there-through." Located around the layers 2 and in contact therewith is an outer pipe 4 "made from galvanized sheet iron or other suitable material".

One end of each pipe is crimped, the outer pipe at 4' and the inner pipe at 1' so as to provide male ends. The opposite end of each pipe left untouched provides a female end. Each section is assembled with the male end 1' of the inner pipe adjacent the female end of the outer pipe. This arrangement places the male end of the outer pipe adjacent the female end of the inner pipe.

The inner pipe is slidable inside the insulation as shown by the dotted line projection in Fig. 3. The insulation, extending full length, within each section of pipe, acts as a guide to hold the two pipes concentric. *The complete sectional unit comprises three elements,—the inner pipe, outer pipe, and insulation.*

When an installation is to be made, and after the lowermost unit of the composite pipe has been placed, the inner tube of the next unit to be assembled is pulled downwardly into the position shown in Fig. 3 and the male end 1' of this inner tube is inserted tightly in the female end of the lowermost tube. *This joint is then inspected,* before the female end of the outer tube 4 (Fig. 3) is slid down onto the upwardly projecting male end 4' of the adjacent lower unit. The assembly of unit on unit of

this flue pipe is accomplished by repetition of the above steps.

This construction provides an inner tube *insulated and spaced* from the outer tube and *slidable in the insulation*; and, when an inner and outer string of tubing is in place leak-proof joints are provided between each unit, preventing any liquid condensing on the walls from the gases in the inner tube from gaining access to the insulating material, and preventing rain and moisture on the outside of the outer tube from gaining access to the insulated material between the tubes. The slidable feature aids assembly and also permits unhampered independent vertical expansion or contraction of either string of tubing, without dangerous loosening of the joints.

The extraordinary merit in Stadtfeld's flue pipe was immediately recognized by all who saw it. Here was the flue pipe the trade had needed so badly and had been searching for so long. Appellant's advertisements paid significant tribute to the originality and accomplishments of the invention. One read: (III. 885)

“Trial installations will prove the following points:

1. Better and quicker draft.
2. Improved combustion.
3. Elimination of excessive condensing of combustion products.
4. Longer life of appliance.
5. Less fire hazard.
6. Lower installation costs.”

These uncontradicted statements coming from appellant point up some of the problems solved by this important invention.

#### THE FLUE PIPE PROBLEM.

In the burning or combustion of a fuel, air combines with the fuel producing flame and heat. The *products of combustion* resulting therefrom are the unburned elements not consumed in the flame and include water, the deadly carbon monoxide gas, various acids, etc. To support combustion there must be a constant supply of fresh air and a constant withdrawal of these products of combustion. The flue pipe is the conduit used to accomplish these two things and to carry out of the building these moist, acid laden, deadly products of combustion, sometimes referred to as flue gases. The potential danger to public health and safety of an improper flue has led to very rigorous laws as to what can and cannot be used (II. 512, 571). The Stadtfeld invention is acceptable under the building codes whereas the prior art devices are forbidden.

One important phase of the flue pipe problem was to obtain an adequate *self-induced* draft in the flue to insure entry of sufficient air to the burner to maintain combustion. This required maintaining the flue gases in the flue pipe well above the dew point temperature (135-140° F.). If flue gases drop below the dew point in the stack two things take place: first, condensates (a liquid) form on the walls of the flue and flow back into the appliance, and second, the upward rush of air through the flue is halted,

bringing a consequent reduction in the amount of fresh air sucked into the burner to maintain combustion. Such a condition of choked draft establishes a *floating flame*, which is easily blown out. Deaths due to gas poisoning have resulted from this condition.

Another phase of the flue pipe problem was to obtain a *quick draft* so that appliances such as a stove or water heater would quickly reach a safe burning condition as well as the most efficient operating condition. Earlier flue pipes, as well as the so-called patent chimneys, \* required a long warm-up period before the proper draft was established and were accountable for the dangerous gas smells noticed in the house (II. 572).

Another phase of the flue pipe problem from the standpoint of the manufacturer (primarily interested in the efficient useful consumption of the maximum number of b. t. u. (British thermal units) in the appliance it manufactures) was that *the temperature of the flue gases leaving the appliance outlet* should be as low as possible. This low limit was arrived at by measuring the temperature drop of the gases as they passed up the flue (e.g., 110°) and adding to this the dew point temperature (e.g., 140°),—for when exhausted from the appliance the gases must contain sufficient heat to maintain the stack temperature above the dew point to the very top. In the example the appliance outlet temperature is 250°.

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\*A tile inner pipe with cemented joints and a metal outer casing (II. 567).

The manufacturer was also interested in a flue which would operate with a *minimum of condensation*, for the less the condensate flowing down into the appliance, the less the problem of rust and deterioration of the appliance, the longer its life.

Another phase of the problem was *removal of fire hazard*, arising in other flue pipes from insecure joints, from rusting out of the flue due to the acid action of excessive condensation, from improper insulation, from a flue that would not warm up quickly, etc.

Allied with this problem was that of the *carbon monoxide deaths* resulting from the seepage of these deadly fumes into living quarters of dwellings. The demand of municipalities for a flue pipe which would put a stop to the many deaths from this cause was long a *spur* to the industry to develop a safe flue pipe.

Another phase of the problem was to devise a pipe which could be quickly, easily and safely erected at a minimum labor cost.

Another phase of the problem was to protect the insulation from condensates.

*Stadtfeld's invention solved each and every one of these problems.* Every one realized it. Today there does not exist another flue pipe so efficient or successful as the pipe of the patent in suit.

On the record there is no room to dispute the radical novelty and patentability of the invention made by Stadtfeld. Its utility and value must be conceded, because appellant makes an exact copy of Stadtfeld's invention,



and although giving its praise to the prior art, it does not use the prior art.

*Diamond Rubber Co. v. Consolidated Tire Co.*,

220 U. S. 428 at 441;

*Sandy MacGregor Co. v. Vaco Grip Co.*, 2 F. (2d)

655, 656 (C. C. A. 6);

*Sachs v. Hartford*, 47 F. (2d) 743, 746, 747

(C. C. A. 2).

Its novelty cannot be disputed because:

Stadtfeld was the first to devise a flue pipe of metal or any other suitable material which gave *a quick rise in stack temperature,—four or five times faster* than other flue pipes (II. 515). The draft was established *almost immediately* (II. 515). *This was a new result.*

Stadtfeld was the *first to teach the importance* in such a flue pipe of *insulating the inner tube* in order to maintain high stack temperatures. *This led to a new method of functioning.*

The gas appliance manufacturer now could design appliances to use up more of the b. t. u. s for useful purposes because *less heat was consumed in the stack to maintain a draft*. This meant more efficiency and economy in fuel consumed (II. 515).

Stadtfeld was the first to solve *the condensate problem*, which he did by so well insulating the inner pipe carrying the gases that the inner pipe wall temperature almost *immediately* rose above the dew point and thereby eliminated any chance for the gases to condense thereon. *This was a new concept,—putting the insulation directly around*

the pipe carrying the flue gases *to keep the pipe hot*. Earlier workers in this art had missed that point entirely, and as shown by the abandoned Los Angeles pipe (infra, p. 73), were going on a theory the *very antithesis of Stadtfeld's*, namely, to have air contacting directly against the outside of the inner pipe carrying the flue gases and to apply the insulation only on the outer tube so that if the latter became overheated it would not set fire to the building.

Stadtfeld was the first to provide sectional flue pipe units with inner and outer tubes adapted to be independently connected and supported and having *insulation in between the two tubes* and forming each end of the tubes into *male and female* ends suitable for connecting complementary ends to each adjacent unit. This provided leak-proof joints.

Stadtfeld was the first to devise in this combination *the sliding of the inner tube with relation to the outer tube* so that it was possible to slide the inner tube of one unit down and make the joint with the inner tube of the adjacent unit before the outer tube was lowered to complete its joint with the adjacent outer tube. This speeded up installation *three or four times faster than other flue pipes* (II. 515) and made possible the inspection of every joint as the flue was assembled, unit by unit. *Its method of installation was new*.

Stadtfeld was the first to devise flue pipe units composed of relatively short slidable sections so that when a plurality were connected the inner string of tubing would be *joined and supported independently* of the outer string

of tubing and in which these concentric tubes of each unit were *spaced and insulated* from each other by layers of air cell asbestos wound between them.

Thus, we see why the trial court found, among other things, (Fdg. 12, I. 51) that Stadtfeld made “a substantial and meritorious advance over anything found in the art”; that it “required inventive genius to produce”; and (Fdg. 16, I. 53) that his invention “has solved a problem of long standing in that art and has gone into wide and successful commercial use”. Nothing advanced in appellant’s brief shows any error in these findings, in fact, its brief does not even refer to these findings.

#### THE STADTFELD DISCLAIMER.

The patent in suit, as we saw, contains a clear cut disclosure of Stadtfeld’s flue pipe invention, comprising a unit having the three elements,—the outer tube, the insulation and the inner tube slidable within the insulation. It explains fully the construction of these three elements and their assembly into a unit so that the units can be put together section on section to make a complete flue pipe. The patent has three claims and we shall deal with claim 3 as representative. Each claim was qualified by a disclaimer which had the effect of rendering “more certain that which he had invented” (*Carson v. A. S. & R. Co.*, 4 F. (2d) 463, 469 (C. C. A. 9)).

The patent in suit presents a simple and typical case of an inventor through inadvertence, accident or mistake using language in the claim capable of covering more than that of which he might be considered the original or

first inventor or discoverer. The patentee, with the usual and natural enthusiasm of an inventor and lack of technical patent knowledge, accepted the claims in their broadest form. During the final stages of preparation of the case for trial it seemed that the *language* of the claims, rather than the spirit of the invention, might possibly reach out and include a wider range of equivalents than intended. The many cases on qualifying disclaimers (pp. 31-43, *infra*) were examined and, following court approved practice, appellee promptly paid the regular Government fee and filed “*a precautionary disclaimer*” (*Permutit v. Wadham*, 13 F. (2d) 454, (C. C. A. 6)), so that there would be no opportunity for anyone contending that the claims were to be read, construed, or intended as covering any invention different than that disclosed in the specification and drawings.

In view of the clear showing in the drawings and the description in the specification, there could be no mistake about what invention the claims were intended to cover because the well-known rule is that a claim must be read and construed in the light of its own specification.

“The true rule is that the specification of a patent, which forms a part of the same application as its claims, must be read and construed with them \* \* \* for the purpose of ascertaining their true meaning and the actual intention of the parties when they were made and allowed. *Seymour v. Osborne*, 11 Wall. 516, 547.”

*O. H. Jewell Filter Co. v. Jackson*, 140 Fed. 340, 344 (C. C. A. 8).

See also: *Davis, etc. v. Schick Dry Shaver, Inc.*, ..... F. (2d) ..... (C. C. A. 9); 48 *Corpus Juris* 223.

However, on the eve of trial the patentee and his assignee recognized for the first time the possible ambiguity of the claim language as to whether they were or were not definitely limited to the specific three elements of the structure described and they recognized that, if they should be misconstrued as not so limited, they might be held broad enough to reach non-analogous devices of which the patentee was not the original or first inventor. To avoid this risk and to remove any possible ambiguity the qualifying disclaimers as to these claims were filed, changing them from generic to specific claims.

### Claim 3

**Introductory Clause** "A composite pipe construction comprising

**Element 1.** an inner core pipe,

**Element 2.** an external pipe spaced from the inner pipe, and

**Element 3.** insulating material interposed between the two pipes, the said pipes being *telescopically* arranged with respect to one another."

By the qualifying disclaimer (III. 638) claim 3 was changed from a generic to a specific claim by placing the following limitations on its three elements and introductory clause.

### Introductory Clause Limited.

The introductory clause of the claim was limited so the “*combination of the recited elements in claim 3*” was disclaimed

“except for composite sectional pipes for conducting ‘fluids or gases of combustion’ ”,

*Note:* This was an environmental limitation which had the effect of narrowing the scope of the claimed three element combination to use in composite flue pipe units. For court approved precedents see limitation (a) in *Byrne* decision (p. 32, *infra*) or (d) in *Metropolitan* decision (p. 34, *infra*). It is important to note the disclaimer’s opening words “*combination of the recited elements in claim 3*” which clearly keep the claim one for a single unit and do not change it to cover a plurality of units. (Further discussion at pp. 43-45, *infra*.)

### Elements 1 and 2 Changed to Specific From Generic.

The structure of the inner core pipe (element 1) and the external pipe (element 2) originally were generic, that is, not limited by the claim language to any particular form. Of course they were limited by interpretation to elements in a form which would accomplish the spirit and object of the invention as set forth in the specification and drawings (see cases *supra*, p. 18). The specification and drawings showed a specific construction of each tube formed with crimped male ends and untouched female ends set opposite end to. The disclaimer changed the pipes from a generic to a specific form. This removed breadth from the original claim language by disclaiming elements 1 and 2 of the composite pipe unit:

“*except when* ‘adjacent ends of the inner and outer pipes of each section’ have

‘male and female’ ends with

the male ‘end of the inner pipe’ ‘located adjacent the female end of the outer pipe’, and

‘with the male end of an inner tube pointing downwardly and’

*adapted to be* ‘fitted inside the female end of the adjoining lower section’

so that ‘any condensates forming inside the said inner pipes are carried over the joint’, and

‘with the male end of’ the ‘outer pipe of a section pointing upwardly and’

*adapted to be* ‘located inside the female end of the next higher pipe of *another* section,’

so that ‘a joint is provided which sheds any exterior moisture running downwardly over the outer pipes,’ and

the completed joints between ‘adjacent ends’ of adjoining sections

‘of the inner and outer pipes’ are in substantial radial alignment, and \* \* \*’

*Note:* These words which make elements 1 and 2 specific instead of generic and further specify their manner of functioning were based on such precedents as the Supreme Court rule has approved (p. 26, *infra*) and are on all fours with the exact facts of the *Byrne* decision (see limitations (b) and (c) *infra*, p. 32).

The important functional relationship of free slidability or telescoping of elements 1 and 2 is further stressed by

the disclaimer in the following narrowing statement about these elements, disclaiming them,

“except when each string of connected pipe, outer and inner, is independently supported and maintained in connected relationship”.

### Element 3 Is Limited Functionally.

The final limitation introduced by the disclaimer is to name another function of the third element “insulating material” as providing

“an intermediate filler”.

*Note:* This functional statement merely specifies one of the offices performed by the third element. See limitation f, *Metropolitan* decision *infra*, p. 34.

If one now glances back over the disclaimer and claim it will be obvious that the invention described comprises three elements, the two pipes (elements 1 and 2) and the insulation (element 3). The only physical or structural change effected in claim 3 by the disclaimer language was to provide that one end of each tube (elements 1 and 2) should be crimped in at 1' and 4' to *adapt each* for a male fit inside the female end of another unit. This did not add an element but simply defined elements 1 and 2 in a more specific manner. No change was necessary in the tube to provide the female end. Every other narrowing limitation effected by the disclaimer was by statement of function particularizing about the relation of the three elements to one another.



**Trial Court's Findings On the Disclaimer.**

The court below in upholding these qualifying disclaimers made the following findings:

7. The claims of the patent in suit were narrowed in scope by qualifying disclaimers filed in the United States Patent Office on February 25, 1938, pursuant to U. S. Revised Statute Section 4917, when it appeared to plaintiff that through inadvertence, accident or mistake their language was of undue breadth, and permitted an interpretation broader than was intended. Each limitation was taken directly from the specification of the patent as originally filed and each only modifies the three elements of the claims without adding new elements.

8. The claims, as narrowed in scope by the qualifying disclaimers, are not like any claim abandoned during prosecution of the application.

9. The claims, after disclaimer, as before, cover a single section of pipe and not a plurality of sections.

These findings are manifestly correct and cover every phase of the disclaimer matter.

The contentions advanced by appellant depends upon an erroneous interpretation of the disclaimer statute and upon complete disregard of the controlling authorities.

As noted earlier, appellant's brief refers only to finding 7 and omits any reference to the trial court's findings 8 and 9 on the disclaimer, and findings 11, 12, 13, 14, 15, 16 and 22 sustaining validity of the claims. Because the issues before this Court revolve around the correctness

of the trial court's findings, we shall attempt to establish some order by considering the findings we believe are questioned by appellant's arguments. These arguments will be answered in the course of our argument under the following headings:

#### SUMMARY OF ARGUMENT.

1. *As to Finding No. 7*—The court below correctly followed the Supreme Court and other courts in recognizing that under the Disclaimer Statutes a patent owner may qualify or further define the elements in the claims. (Post, pp. 26-30.)

2. *As to Finding No. 7*—The trial court correctly found the Stadtfeld qualifying disclaimer fully complies with the Disclaimer Statutes since it only modified or narrowed the original elements in the claims without adding new elements, and is the prototype of those approved by the Supreme Court and other courts. (Post, pp. 31-43.)

3. *As to Finding No. 9*—The disclaimer did not change the claims to cover a plurality of sections of pipe instead of a single section, as does appellant's imaginary disclaimer claim, and the court below correctly found this to be the fact. (Post, pp. 43-46.)

4. *As to Finding No. 7*—A proper limiting disclaimer does not require re-examination of the claims and is not an invasion of the reissue statute, because it adds no elements to the claims. (Post, pp. 46, 47.)

5. *As to Finding No. 7*—It is an essential for a valid qualifying disclaimer that the limitations introduced by

disclaimer shall be disclosed in the drawings and specification. (Post, pp. 47, 48.)

6. *As to Finding No. 7*—The Disclaimer Statutes permit narrowing of claims by a qualifying disclaimer and the law does not interpret this as an admission that the original claims were invalid. (Post, pp. 49-52.)

7. *As to Finding No. 7*—The trial court correctly found there was “inadvertence, accident or mistake” and no wilful fraudulent intent to claim more than his invention, and the disclaimer was filed promptly “when” the need became apparent. (Post, pp. 53-57.)

8. *As to Finding No. 8*—The disclaimer did not make the claims coextensive with rejected claims 3, 4, 5 or 8 or amount to reclaiming rejected subject matter and the court below correctly found this to be the fact. (Post, pp. 57-59.)

9. *As to Finding No. 22*—The claims are for a patentable combination and not an aggregation, as the trial court correctly found. (Post, pp. 59-61.)

10. *As to Findings Nos. 8, 11, 12, 13, 14, 15, 16 and 22*—The patented invention was novel and it is not disclosed in the prior art, as the trial court correctly found. (Post, pp. 61-81.)

11. The Stadtfeld original claims 1, 2 and 3 and cancelled claims 3, 4, 5 and 8 are not prior art and cannot be used as such to anticipate the patent. (Post, pp. 81-85.)

1. AS TO FINDING 7—THE COURT BELOW CORRECTLY FOLLOWED THE SUPREME COURT AND OTHER COURTS IN RECOGNIZING THAT UNDER THE DISCLAIMER STATUTES A PATENT OWNER MAY QUALIFY OR FURTHER DEFINE THE ELEMENTS IN THE CLAIMS.

Because appellant's brief gives erroneous, half complete consideration to the law of disclaimers a careful brief review is necessary.

#### The Supreme Court's Four Classifications of Disclaimers.

In 1837 Congress passed the first Disclaimer Statutes, the provisions of which are embodied in the present law substantially without change (R. S. U. S. Sections 4917 and 4922—35 U. S. C. A. Sections 65 and 71, printed in appendix p. vii). In the intervening century the disclaimer statutes have come to be used for at least four different purposes recently classified as follows by the Supreme Court:

“The use of the *disclaimer* has been upheld where the elimination from the patent of the matter not relied upon *did not operate to enlarge the monopoly of the patent, but narrowed it,*

(1) as by eliminating in their entirety some of the claims of the patent, *Sessions v. Romadka*, 145 U. S. 29, 40, 36 L. Ed. 609, 613, 12 S. Ct. 799. See *Union Metallic Cartridge Co. v. United States Cartridge Co.*, 112 U. S. 624, 642, 28 L. Ed. 828, 833, 5 S. Ct. 475;

(2) or by striking out an alternative method or device, *Dunbar vs. Meyers*, 94 U. S. 187, 192, 194, 24 L. Ed. 34, 36, 37; *Hurlbut v. Schillinger*, 130 U. S. 456, 32 L. Ed. 1011, 9 S. Ct. 584; *Carson vs. Ameri-*

*can Smelting & Ref. Co.*, 4 F.(2d) 463, 469, 470 (C.C.A. 9);

(3) or by limitation of a claim or specification by deletion of unnecessary parts, *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 435, 436, 46 L. Ed. 968, 985, 986, 22 S. Ct. 698; *Marconi Wireless Teleg. Co. v. DeForest Radio Teleph. & Teleg. Co.*, 243 F. 560, 565 (C.C.A. 2);

(4) or by limiting the claim to a specific type of the general class to which it was applied, *Minerals Separation v. Butte & S. Min. Co.*, 250 U. S. 336, 354, 63 L. Ed. 1019, 1027, 39 S. Ct. 496; *United Chromium v. International Silver Co.*, 60 F.(2d) 913, 914 (C.C.A. 2); *Seiberling v. John E. Thropp's Sons Co.*, 284 F. 746, 756, 757 (C.C.A. 3).''

*Altoona Pub. Theatres v. Am. Tri-Ergon Corp.*, 294 U. S. 477, 490, 79 L. Ed. 1005, 1014 (Foot-note 3).

Under Class 1 the disclaimer is used to cancel or eliminate part of the patent. This form of disclaimer simply renounces any right to protection with respect to one or more claims regarded as invalid. Need for such use arises when a court holds a claim invalid and it must be disclaimed or amputated promptly to save the life of the other claims. A typical case is *Otis Elevator Co. v. Pacific Finance Corp.*, 68 F. (2) 664, 670 (C. C. A. 9).

Under classes 2, 3 and 4 the disclaimer is used *not to renounce a claim in its entirety, but to limit the scope of a claim or claims*. This is known as a *qualifying disclaimer* or a "precautionary" disclaimer. Thus, if the claim originally embraces a genus the disclaimer may re-

strict it to a species, or it may exclude “part of the field of equivalency which the original claim language might have included” (*Nelson v. Meyers*, 29 F. (2d) 968 (C. C. A. 6)).

Because the first type disclaimer renounces or abandons the claim and qualifying disclaimers do not renounce or abandon the claim but merely introduce qualifying limitations, it is obvious that different considerations are applicable. For example, under the first classification, where a claim has been held invalid, filing of a disclaimer is properly held an admission that the claim is invalid. However, a qualifying type disclaimer, under the other classifications, is held to carry no such admission.\* Another example of the difference between the first classification and the others is in what is given up. In the first type the disclaimer cancels the whole claim. With the qualifying disclaimer the disclaimer *holds the claim but gives up scope*, since it introduces additional limitations, the effect of which are to narrow the claim.† *Appellant’s arguments ignore any distinction between these two types of disclaimers.* They consistently misapply law applicable only to disclaimers of invalid claims (the first class) to the present qualifying disclaimer.

#### Essentials of a Qualifying Disclaimer.

The many cases on valid qualifying disclaimers (all ignored by appellant) have developed a definite yardstick, variously expressed in the cases, by which the

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\*See authorities, pp. 49, 83, *infra*.

†See authorities, p. 29, *infra*.

validity of such disclaimers is to be measured. The substance of these cases is that qualifying language may validly be used, as in the present case, to further define the structure and characteristics of elements already in the claim and may be used to introduce narrowing functional statements about the elements and the general field the claim is intended to cover. However, the qualifying language of the disclaimer must not add a new element or elements to the claim.

Once the qualifying disclaimer is recorded, the Supreme Court says it:

“becomes a part of the original specification, and must be taken into account in construing the patent and in ascertaining the rights of the parties to the suit. \* \* \* The only effect of the disclaimer in such a case is to limit the nature of the invention secured by the patent and to diminish the claims of the patent as set forth in the specification.” (*Dunbar v. Myers*, 94 U. S. 187, 193, 194.)

Appellant is mistaken in asserting (p. 33, line 5) that in every case “upon the filing of disclaimers the original claims are withdrawn from the protection of the patent laws and the public is entitled to manufacture and use the device originally claimed as freely as though it had been abandoned”. This language is taken from page 492 of the *Altoona* case, *supra*, and is applicable only to its facts where the court was discussing the effect on the claims of a disclaimer which it held defective. Appellant omits quoting an important sentence, “With the *invalid* disclaimer must fall the original claims as they stood be-

fore the disclaimer'' (p. 492). Contrast this with the above quotation from *Dunbar v. Myers*, in which case the court said the only effect of a *valid* qualifying disclaimer on the original claims is ''to limit and qualify the claims \* \* \* to limit the nature of the invention secured by the patent'' (p. 193). The rule applicable in all cases of proper qualifying disclaimers is that the patent owner gives up to the public only the unintended scope the original claim language might have included (*Sachs v. Hartford*, 47 F. (2nd) 743, 746 (C. C. A. 2)).

The universal attitude of the courts with regard to qualifying disclaimers is well stated by this Court in *Carson v. American Smelting & Refining Co.*, 4 F. (2d) 463, 469, 470 (C. C. A. 9), where the court said (p. 469):

''If such was the scope of his invention, *we are unable to see why he could not by disclaimers clarify his claim and render more certain that which he had invented.*''

And again, on page 470:

''Numerous other decisions trend to the doctrine that the *right of disclaimer* is remedial, and is *entitled to a liberality of treatment*, so long as the claim is not mutilated, *and nothing new is imported into it*, and no deception or fraud is practiced.'' (Citing authorities).



2. AS TO FINDING No. 7—THE TRIAL COURT CORRECTLY FOUND THE STADTFELD QUALIFYING DISCLAIMER FULLY COMPLIES WITH THE DISCLAIMER STATUTES SINCE IT ONLY MODIFIED OR NARROWED THE ORIGINAL ELEMENTS IN THE CLAIMS WITHOUT ADDING NEW ELEMENTS, AND IS THE PROTOTYPE OF THOSE APPROVED BY THE SUPREME COURT AND OTHER COURTS.

In the present case and in every case of a disclaimer which introduces new wording into the claims the primary inquiry is whether that new wording imports into the claim one or more new elements, or whether *that wording merely further defines the structure and characteristics of elements already in the claim*. This issue was put squarely before *the District Court* and it made *its finding that Stadtfeld's disclaimer did not add an element to the claims but merely limited or modified the three elements already in the claims*, for the claims before and after disclaimer consisted only of three things,—*the outer pipe, the inner pipe, and the insulation*. The disclaimer only made more specific the definition of these three parts.

The manifest correctness of the trial court's finding is clear as seen from the following authorities:

**The Schwartz Qualifying Disclaimer.**

The Schwartz qualifying disclaimer held valid in *Byrne Mfg. Co. v. American Flange & Mfg. Co.*, 87 F. (2d) 783, 784 (C. C. A. 6) presents one of those rare instances in patent practice where the facts of the earlier case substantially parallel the pending case. *Note that the Schwartz disclaimer and Stadtfeld disclaimer both deal with the form of the end of a tube*. In Schwartz it is the

tubular bushing 4 and in Stadtfeld the tubes 1 and 4. The Schwartz invention was for a bushing 4 which could be inserted in a hole 2 in a metal container 1 and secured in place by rolling the marginal portion 4c over upon and around the edge of the annular flange 2 forming the hole. The claim and disclaimer follow:

Claim 1	Disclaimer to Claim 1	Three Characteristics Given by Disclaimer:
<p>annular BUSHING (4) having flange with edge portions (4b) upon its perimeter at different distances from the axis of the bushing, in combination with SUPPORT (1) through which the bushing extends and formed with a SEAT (7) that has portions (7a) which engage the aforesaid edge portions (4b) of the flange perimeter to hold the bushing from rotation with respect to the support.</p>	<p>Here disclaims from the scope of said claim 1</p> <p>a. all annular bushings in combination with a support, in which the SUPPORT (1) is not A METAL CONTAINER having a hole in which the BUSHING (4) is sealed by</p> <p>b. ROLLING THE MARGINAL PORTION (4c) OF THE BUSHING (4) OVER, UPON AND AROUND the edge of</p> <p>c. AN ANNULAR FLANGE (2) SURROUNDING THE HOLE</p>	<p>a. specifies environment, limiting scope to certain class of SUPPORT instead of all supports</p> <p>b. particularizes as to form of end of tubular BUSHING</p> <p>c. particularizes as to form of SEAT</p>

Schwartz' claim 1 before disclaimer called broadly for the bushing element with a flange 4b and did not specifically name the marginal portion 4c. This is analogous to Stadtfeld's original claim 3 (p. 19, supra) which called broadly for the pipe elements 1 and 4 and did not specifically name the male ends 1' and 4'. The qualification added by Schwartz' disclaimer narrowed this ele-

M. SCHWARTZ

BUSHING

Filed Aug. 17, 1922



Fig. 2

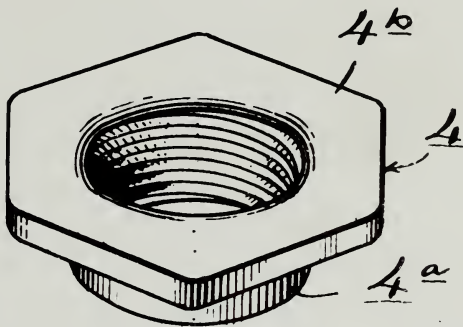


Fig. 3

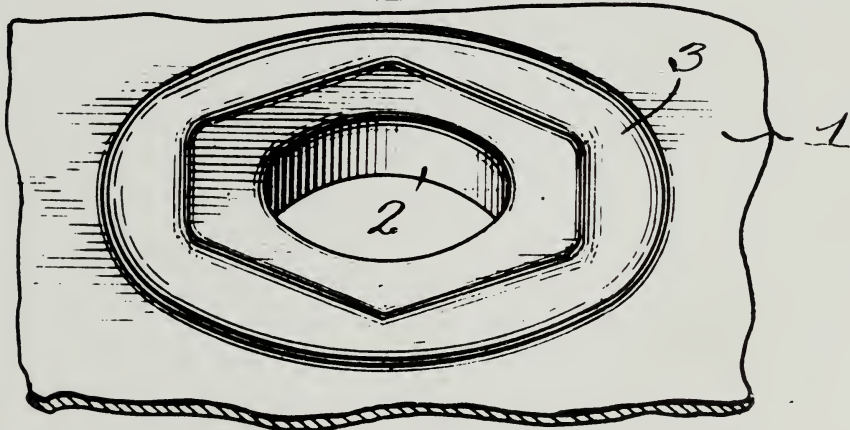
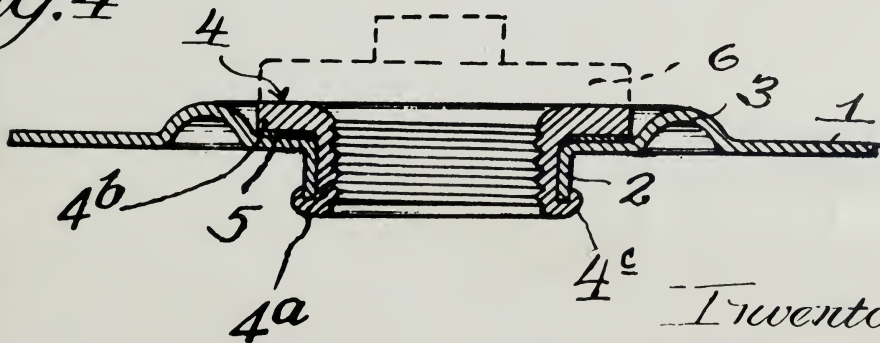


Fig. 4



Inventor,

Morris Schwartz,

By Alfred Wade Huston & Co. Attys.



ment (the bushing 4) from a generic to a specific form by specifying that its marginal portion 4c be given a certain rolled characteristic (see (b) above and Fig. 4 of the drawings). In the same manner the Stadtfeld disclaimer narrowed the pipe elements 1 and 4 from a generic to a specific form by specifying that one end of each be crimped or rolled in to form a male end. Schwartz' disclaimer also made more specific the SEAT by specifying "an annular flange surrounding the hole (see c above). The third thing Schwartz' disclaimer did was to narrow the scope of the claim by specifying environment in the introductory clause thus limiting the claimed combination to a certain kind of support instead of all supports (see a above). This is like Stadtfeld's disclaimer which narrowed the scope of claim 3 to the combination of the recited three elements only for composite sectional flue pipe (p. 20, supra).

The court, in the *Schwartz* case, said (p. 784):

"It is urged that this disclaimer enlarges the scope of claims 1 and 3 of Schwartz and is therefore invalid. *We think otherwise. The disclaimer adds no new element. The effect of it as to claim 1 is to limit the engagement between the perimeter of the laterally projecting flange of the bushing and its seat to certain characteristics; \* \* \* See Wood vs. Peerless Motor Car Corp., 75 F.(2d) 554, 556 (CCA6); N. O. Nelson Mfg. Co. v. F. E. Meyers & Bro. Co., 29 F. (2d) 968, 969 (CCA6)."*

#### **The Torchio Disclaimer.**

In *Metropolitan v. Cleveland*, 36 Fed. (2d) 477 (C. C. A. 6), the court held a similar qualifying disclaimer valid

where all the disclaimer did was to modify the five elements already called for by the claim by words of structural limitation and functional statements (f for example) taken from the patent specification. These added words of structural limitation and function (noted by italics) removed from the five elements of the claim any uncertainty as to the breadth of interpretation the words of the claim were intended to have,—they simply scaled down its breadth, as in the Stadtfeld disclaimer.

**Claim 3 of Torchio Patent\***  
**1,172,322:**

- “An electric cable, comprising
1. *a sheath,*
  2. *a line conductor* having a joint,
  3. a body of pervious *insulating material* inclosing said joint, the said sheath being removed for a distance sufficient to expose said pervious body,
  4. *a sleeve of impervious material* of greater diameter than said body, inclosing the same and hermetically united at its ends to said cable sheath, and
  5. *an insulating fluid* adapted to permeate said pervious body contained in the space between said body and said sleeve.”

**Torchio Disclaimer**

Hereby makes disclaimer of the improvement described except for electric cables, which comprise,

- (a) a line conductor
- (b) insulating *wrappings* permeated with insulating compound, and
- (c) a sheath of *flexible inelastic metal* constituting
- (d) *a unitary product of manufacture and commerce which is portable and capable of being drawn through conduits;* and
- (e) except as to an insulating liquid *which is fluid at ordinary working temperatures of such cables* and
- (f) *in quantity sufficient to supply at all times the demands made by the cable in use, and by the joint.”*

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\*The patent in suit was subsequently held invalid by the United States Supreme Court in a later case on the basis of new prior art, but no question was raised by that court as to the propriety of the disclaimer. (292 U. S. 69).

The court said (pp. 478, 479):

“The record carries no suggestion of any intent to broaden the claims beyond the specification (tit. 35, Sec. 65, U. S. C.), or any idea of obtaining the benefit of a reissue. *We think the effect of the disclaimer is to clear up an awkwardly worded, and therefore a somewhat ambiguous, description in the specification.* See *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 436, 22 S. Ct. 698, 46 L. Ed. 968; *Simplex Ry. Appliance Co. v. Pressed Steel Car Co.* (C.C.A.) 189 F. 70, 72. We also think that the disclaimer was not unreasonably delayed. As stated in *Sessions v. Romadka*, 145 U. S. 29, 12 S. Ct. 799, 801, 36 L. Ed. 609: ‘*The power to disclaim is a beneficial one and ought not to be denied except where it is resorted to for a fraudulent and deceptive purpose.*’ In *Excelsior Furnace Co. v. Williamson Heater Co.*, 269 F. 614, 619, (C.C.A. 6), the disclaimer was allowed after decision on appeal. See, also, *N. O. Nelson Mfg. Co. v. F. E. Meyers & Bro. Co.*, 29 F. (2d) 968, 969 (C.C.A. 6). The view we take is that the *matter* of disclaimer was within the discretion of the patentee to be reasonably exercised—‘a matter of policy’—*Permutit Co. v. Wadham*, 13 F.(2d) 454, 457 (C.C.A. 6), and we think there was sufficient doubt as to whether claims 3 and 4, as originally written, were anticipated to justify the seeming delay. *Walker on Patents* (2d Ed.) §255.”

This same type of qualifying disclaimer has been approved in many other cases and Stadtfeld has followed exactly the practice set forth. (Supreme Court note 3—*Altoona* case 294 U. S. 477, 490; *Minerals Separation v. Butte & S. Min. Co.*, 250 U. S. 336, 354; *United Chromium*

*v. International Silver Co.*, 60 F. (2d) 913, 914 (C. C. A. 2); *Seiberling v. John E. Thropp's Sons Co.*, 284 Fed. 746, 756, 757 (C. C. A. 3); *Van Meter v. Irving Air Chute Co.*, 27 F. (2d) 170, 172 (N. Y.); *Permutit Co. v. Wadham*, 13 F. (2d) 454, 457 (C. C. A. 6); *N. O. Nelson Mfg. Co. v. F. E. Meyers & Bro. Co.*, 29 F. (2d) 968, 969 (C. C. A. 6); *Nelson v. F. E. Meyers & Bro. Co.*, 56 F. (2d) 512, 513 (C. C. A. 6); *Sachs v. Hartford*, 47 F. (2d) 743, 746 (C. C. A. 2); etc.

#### Valid Qualifying Disclaimers Cited By the Supreme Court.

The three cases cited in the Supreme Court's note in the *Altoona* case (supra, p. 26) throw additional light on the fact that the courts universally recognize that a *patentee is entitled to use the disclaimer statute to limit the claims to a specific type of the general class.*

In the *Minerals Separation* case (supra) the Supreme Court sanctioned a disclaimer which limited the amount of oil "to a fraction of 1%"—a specific amount, whereas the claim before disclaimer called for "a small quantity of oil". In the *United Chromium* case (supra) the limitation introduced into the process claims was that the radical must be regulated in maintaining the efficiency of the bath. The claim originally called merely for the bath and the disclaimer introduced the above limitation for regulating the bath. In the *Seiberling* case (supra) the four elements of the original claim were limited by the disclaimer to a tire making machine which was only:

"constructed and co-ordinated for *shaping and applying* a previously unshaped sheet fabric strip to



*that part of the recited ring core beyond the tread portion and unless the power drive for the ring core functions by a sufficiently high speed of rotation and consequent centrifugal force to throw the unapplied fabric portion out from the side of the ring core, while the recited spinning roll in its radial movement, and while pressed toward the ring core, functions by a gradual action upon such centrifugally thrown-out fabric to shape it to the side of the rotating ring core while bringing it into adhesive contact therewith.”* (p. 757)

This functional limiting statement is particularly relevant to the Stadtfeld disclaimer (p. 21, *supra*).

In all these cases the respective defendants, as they always do in any disclaimer case, made the argument that the disclaimer introduced new elements, but as Judge Learned Hand said in the *United Chromium* case, “Much of the defendant’s argument depends upon an *illegitimate inference* from the disclaimer \* \* \*” (p. 914). “We do not, however, agree that a disclaimer has the effect asserted.”

#### **Appellant Ignores the Controlling Cases.**

Appellant’s whole argument (e.g., p. 33) about the disclaimer ignores completely any reference to the above cases which are really determinative of the present controversy. Nowhere does appellant indicate that there is a rule of law which permits a patentee to do what was done in the present case and *use the disclaimer statute to introduce limitations into the claims to make elements specific instead of general*. Instead, appellant closes its eyes to that body of law and cites (p. 33) only a line of cases dealing with different fact situations where attempts were

made to use the disclaimer statute to introduce additional elements into the claims. There is a very distinct zone separating these two lines of cases.

#### The Altoona Case Is Distinguishable On Its Facts.

We can start with the principal case on which appellant relies,—the *Altoona* case (supra)—and get its facts clearly in hand. From this case three things will become apparent: first, that the Altoona disclaimer was invalid because it added an element,—a flywheel; second, that because of this fact it is distinguishable from the Stadtfeld disclaimer which merely particularized about the elements; and third, the Supreme Court in a footnote distinguishes that type case from the line of cases sanctioning the Stadtfeld type of qualifying disclaimer.

In the *Altoona* case claim 13 had four elements. The disclaimer added a fifth element,—“a flywheel”.

#### The claim's elements

- (1) a photoelectric cell
- (2) means (a feeding device) for imparting to the film a rapid and uniform motion longitudinally of the film past said cell,
- (3) a source of light, and
- (4) an objective lens.

#### The disclaimer

- (5) a flywheel operatively connected with the film through means which imparts uniformity of motion of the flywheel to the film.

The flywheel was a whole separate new part or element added to the four elements of the claim, making it a five element claim. It was not a structural limitation, qualification, or particularization of any element already in the claim. *It had no antecedent in the claim. This is the im-*

*portant thing to note.* The Supreme Court was careful to point out that, “While this (disclaimer) *statute affords a wide scope for relinquishment by the patentee of part of the patent mistakenly claimed, where the effect is to restrict or curtail the monopoly of the patent,* it does not permit the addition of a new element to the combination previously claimed, whereby the patent originally for one combination is transformed into a new and different one for the new combination” (p. 490).

By way of explaining what it meant to sanction and meant to condemn, the Supreme Court placed in a footnote (#3 on page 490, quoted at p. 26, *supra*) the four classes of situations where a disclaimer is proper. Class four approves “limiting the claim to a specific type of the general class to which it was applied”. In other words, where an element or elements are in a claim in broad language, the patentee can relinquish this broad terminology and “restrict or curtail the monopoly of the patent” to a particular construction for elements broadly referred to. *A claim thus limited is still for the same combination of elements.* This is what Stadtfeld did. The important thing in any such case is that the elements of the “general class” made into a “specific type” by the disclaimer should have been in the claim to start with. In neither the *Altoona* case nor the other cases relied upon by appellant is this the fact.

The *Fruehauf Trailer* case, 67 F. (2d) 558 (C. C. A. 6) cited by appellant (p. 33) is another in which the disclaimer, instead of limiting elements already in the claim,

introduced a new element. The claim and disclaimer are outlined below:

**Claim 22**

“Supporting mechanism for *trailers*, comprising

1. guide members.
2. slide members carried by said guide members.
3. a supporting member pivotally connected to said guide member and adapted for vertical swinging movement, said supporting member having
4. traction wheels or rollers at its lower end, and
5. cooperating means on said guide and slide members for guiding said supporting member in its swinging movements and for causing said supporting member to swing when said slide members are actuated.”

**Disclaimer**

“all supporting mechanism claimed—except that in which the slide members are adapted to be actuated by

- (6) a portion of the tractor when the same is backed under the forward end of the trailer to thereby move the slide members rearwardly and cause the supporting member to be moved upwardly into inoperative position.”

This disclaimer was held defective because it added the tractor as an element not before in the claim. The court can ascertain this easily by noting the five elements originally in the claims, no one of which provides an antecedent basis for the tractor.

**The Lowell v. Triplett Qualifying Disclaimer Is Valid.**

The recent case of *Lowell v. Triplett*, 17 F. Supp. 996 (DC Md.) cited by appellant (p. 33) illustrates the application of both rules under consideration. As in the *Altoona* case and the *Fruehauf* case, the court held that matter added to claim 1 by the disclaimer violated the Supreme Court rule about adding elements. However, in the same

case the court went on to consider and approve changes made in the other claims by disclaimers modelled on the Supreme Court rule about limiting broadly recited elements to specific structure. There is no need to consider the lengthy approved limitations added to all the elements of the claim for a radio invention, as one will serve to make clear the point, namely, that by disclaimer detail of structure can be added to an element already in the claim and not be considered as adding an element, rewriting the claim, or changing the combination:

**One Element of Claim 3**

“separate means connected to each of said *amplifying* and *rectifying* means for eliminating the hum of said alternating current.”

**The Disclaimer as to said Element**

by including construction which connected “*the grid of the amplifying means to the cathode thereof at a point not subjected to the influence of variations of the cathode heating current, and to elements connected between the ‘means for amplifying said signal energy at radio frequencies’ and the ‘means for rectifying said energy’ which prevent the passage of power supply frequencies.*”

The court said (p. 1001):

“Defendants contend that these disclaimers render the claims invalid because they add a new element to each of the combinations described in the claims, namely, that the disclaimers operate to enlarge the claims in such fashion as to render both the old and the new claims invalid by virtue of the reissue statute.”

After referring to the *Altoona* case rule and its footnote, quoted p. 26, supra, the court said:

“We find that the disclaimers have done nothing with respect to all other parts of all three claims

except what is permissible, as we have just seen, *namely, limit the specific claim to a specific type of the general class to which it was applied.* If such were all that had been done in the Altoona case, the disclaimer, we must assume would have been valid,  
 \* \* \*',

The balance of appellant's supposed authorities (p. 33) are lacking in relevancy for similar and additional reasons. For example, in *American Lakes Paper Co. v. Nekoosa-Edwards Paper Co.*, 83 F. (2d) 847 (C. C. A. 7), the limitation sought to be added by disclaimer was not found mentioned in the specification. This same defect existed in *General Motors Corp. v. Rubsam Corp.*, 65 F. (2d) 217 (C. C. A. 6). The analysis at page 21, *supra*, demonstrates that every structural limitation introduced by the Stadtfeld disclaimer is taken directly from the specification of the patent only to modify the three original elements in the claims without adding new elements.

Appellant's only hope of succeeding on the alleged disclaimer defense is for this Court to inadvertently confuse cases of *particularizing about or qualifying generic elements already in the claim by specifying structure, with the other type of cases of adding an element.*

The courts, from the Supreme Court down, as the authorities show, have placed their stamp of approval on disclaimers that merely qualify or further characterize the structure of elements already in the claim, whereas the same courts have disapproved alleged disclaimers which added new elements to the claims. We have no quarrel with either line of cases. Both are good and correct law. Both make extremely important the fact deter-

mination by a court of the issue: Does the disclaimer merely qualify or further characterize the structure of elements already in the claim, or does the disclaimer bring new elements or parts into the claim? On this fact determination lies the whole of the present case.

The trial court very carefully distinguished between those two fact situations and found that plaintiff's disclaimer only particularized about the elements, that is, that it "modifies the three elements of the claims without adding new elements" (Finding No. 7); that after this disclaimer as well as before, the flue pipe claimed has just the three original elements,—the inner tube, the outer tube and the insulation. It is still for the same combination of three elements, but a limited kind of three elements as approved by the Supreme Court note in the *Altoona* case, the *Byrne* case (p. 31, *supra*), and others cited.

We respectfully submit there is no error shown in the trial court's finding No. 7; and that appellant's failure to deal with the law and cases on valid qualifying disclaimer stamps its contention as a makeweight argument.

**3. AS TO FINDING No. 9—THE DISCLAIMER DID NOT CHANGE THE CLAIMS TO COVER A PLURALITY OF SECTIONS OF PIPE INSTEAD OF A SINGLE SECTION AS DOES APPELLANT'S IMAGINARY DISCLAIMER CLAIM, AND THE COURT BELOW CORRECTLY FOUND THIS TO BE THE FACT.**

The unjustified ends to which appellant has gone to give color to its erroneous contention of adding elements is well illustrated in its alleged "disclaimer" claim (p. 28). Unable to make its argument on the basis of the dis-

claimer as it is in the record (III. 638), *appellant proceeds to compose an imaginary "disclaimer" claim all its own* (p. 28). Appellant is unwittingly correct on page 29 when it refers to its new creation as a "purported" disclaimer, for certainly it is nothing that was ever in the record. Appellant's first error comes (p. 28) in the four line introduction to this imaginary claim, which introduction appellant intended would make the claim over into one for a plurality of units. Appellant's introduction departs from the record and is completely silent on the fact (III. 638) that the disclaimer as filed by appellee was only "of any combination of the recited elements in claim 3, except" and so forth (see analysis at p. 20, *supra*). Appellant admits (p. 29) that claim three originally was for a "single length" of pipe. *By using the words "any combination of the recited elements in claim 3", appellee intended to and did retain that same single unit combination in the claim.* Appellant's imaginary disclaimer omits these important words of the actual disclaimer because they refute its argument (pp. 30, 31) that the disclaimer changed the claim from one for a single unit to one for a plurality of units. Nowhere in the disclaimer is the word "plurality" used. What appellant does is also to confuse statements of function where the disclaimer talks about the qualifying limitations made to the inner and outer tube elements and to pay no attention whatever to the words "adapted to be" occurring twice in that section of the disclaimer showing how it is adapted to be used (p. 21, *supra*). These are clearly words of functional limitation describing just one section of composite pipe "adapted to be" connected to other sections. Note also the word "another" to the same



effect. For appellant's erroneous contention (p. 31) to be correct, these words, as well as others, would have to be omitted and many others added.

Appellant's brief is silent on the fact that the trial court made a specific finding that "the claims, after disclaimer, as before, cover a single section of pipe and not a plurality of sections" (Fdg. 9, I. 51). Appellant's brief has not questioned the correctness of this finding, but if the court should take up the finding, the above is a conclusive answer to appellant's erroneous argument.

As nearly as we can make any sense out of the fantastic argument on "The Disclaimer Claims" at page 30, appellant there proposes to combine as its "first element" the three elements which comprise the composite pipe defined in the original patent claims. This is a brand new idea for an "element" original with appellant and not to be found in any authorities. Its argument as to what constitutes the "second element" then wanders off to describe statements of function and qualification of the original three elements. Note that appellant cites no authorities for any of these propositions. The whole trouble is that appellant is proceeding from a false unsupportable premise, assumed because it had no answer to the cases on valid qualifying disclaimers (*supra*, p. 31).

Appellant throughout its brief fights shy of meeting on the controlling issue and cases because it can not win and do so. Instead it has discussed only the distinguishable *Altoona* case and has spent its time, as above, trying to invent ways of twisting our facts to fit the *Altoona* case.

We respectfully submit that appellant's erroneous, unsupported argument, although omitting any reference to it, fails to show any error whatever in the trial court's finding No. 9.

4. AS TO FINDING No. 7—A PROPER LIMITING DISCLAIMER DOES NOT REQUIRE RE-EXAMINATION OF THE CLAIMS AND IS NOT AN INVASION OF THE REISSUE STATUTE BECAUSE IT ADDS NO ELEMENTS TO THE CLAIMS.

Again without any supporting authorities and in disregard of ours, of which it was advised, appellant proceeds at several places (pp. 14, 20, 22, 23) to suggest that instead of a disclaimer *Stadtfeld* should have used the reissue statute. The trouble with appellant's argument is that the facts of the present case don't bear out its contention. If this case were like the *Altoona* case where it was necessary to add the flywheel to the claim as an element, then reissue would have been the remedy. In that event, however, the *Altoona* case alone would dispose of the disclaimer and the case would be closed. What appellant overlooks is that the *Stadtfeld* case falls within the limiting disclaimer statute and not the reissue statute because the three elements are already in the claim and it is only necessary to introduce structural limitations to these three generic elements to make them specific. Appellant's is the stock argument made by every defendant in a disclaimer case.

“Defendant contends that plaintiff's disclaimers were not effective to accomplish the attempted changes in the claims in question, but presented a new and different cause of action, and that the only method of relief in that behalf open to Plaintiff was by ap-

plication for a reissue. *We cannot assent to this contention.* Cf. *Excelsior Steel Furnace Co. v. Williamson Heater Co.* (C.C.A. 6) 269 F. 614, 619, et seq.; also *Michigan Carton Co. v. Sutherland Paper Co.* (C.C.A. 6) 29 F.(2d) 179, decided November 7, 1928. *The specifications of the two Meyers patents were in complete harmony with the claims as effected by the disclaimers.* No change of specification was made or needed. The disclaimer was not a confession of anticipation in the absence of disclaimer. *Permutit v. Wadham* (C.C.A. 6) 13 F.(2d) 454, 457. As in the *Permutit* case, *the disclaimers operated to limit the claims, not by the inclusion of a new element, but by the exclusion of part of the field of equivalency which the original claim language might have included.* We think the disclaimer must be accepted as effective.” (969)

*N. O. Nelson Mfg. Co. v. F. E. Meyers & Bro. Co.,*  
29 Fed. (2d) 968 (C. C. A. 6);

See also *Lowell v. Triplett*, supra, p. 40.

5. AS TO FINDING No. 7—IT IS AN ESSENTIAL FOR A VALID QUALIFYING DISCLAIMER THAT THE LIMITATIONS INTRODUCED BY DISCLAIMER SHALL BE DISCLOSED IN THE DRAWINGS AND SPECIFICATIONS.

The dearth of any worthwhile defense to this case is well illustrated by appellant's abortive attempt (p. 33, last paragraph) to twist a finding of the trial court that “each limitation was taken directly from the specification of the patent as originally filed (Fdg. 7)” into an alleged contention by us that “anything described in the specification or shown in the drawings of the patent is not a new element and can be added to the patent claims”

(appellant's brief page 34, line 1). Such is not the law. *We have never made any such contention.* The trial court very correctly included in its findings the statement that "each limitation was taken directly from the specification of the patent as originally filed". That is a definite prerequisite to a valid qualifying disclaimer. The *General Motors* and the *American Lakes Paper Co.* cases (supra) cited by appellant (p. 33); the *Nelson* case just quoted from (p. 46) and many other authorities so hold. Because it is so important we used mostly direct quotations in framing the disclaimers (III. 638) so there could be no question of the qualifying limitations stemming directly from the specification. We submit such futile arguments would not be made by appellant if there were any sound basis on which its experienced counsel could support their case.

The principle of disclaimer law just mentioned is distinct from the other principle that a qualifying disclaimer must not add an element. Just why appellant goes on (p. 34) to cite cases which are not in point on either rule of law is not clear. We may as well answer them now as later. The *McCarthy v. Lehigh* and *U. S. Peg Wood* cases cited (p. 34) by appellant are not in point because (a) they are not disclaimer cases, and (b) they are merely corollaries to the *Altoona* case rule which alone is sufficient to dispose of the Stadtfeld disclaimer if the court finds it added an element. We have already shown the authorities (p. 31) which control the decision on that issue and fully sustain the trial court's finding.

6. AS TO FINDING No. 7—THE DISCLAIMER STATUTES PERMIT NARROWING OF A CLAIM BY A QUALIFYING DISCLAIMER AND THE LAW DOES NOT INTERPRET THIS AS AN ADMISSION THAT THE ORIGINAL CLAIMS WERE INVALID.

Appellant's argument (pp. 18-23) is further evidence of frantic efforts to grasp at anything in its attempt to avoid the realities of this case. Having shut its eyes to the qualifying disclaimer cases and the four disclaimer classifications made by the Supreme Court note (p. 26, supra), it proceeds here to misconstrue the disclaimer statutes and to deal with disclaimers as if they were all like class one.

(1) Appellant first misconstrues the disclaimer statutes by asserting erroneously that they "permit only a disclaimer of a material or substantial part of the thing patented" (p. 19, 7 lines from the bottom) and that "the thing patented is the thing" (in the case at bar, the combination) "particularly pointed out and distinctly claimed (R. S. 4888)." In other words, appellant thereby erroneously asserts (p. 21, line 5) that you can only disclaim a claim.

(2) Then appellant on this false construction of the statutes bases an erroneous premise that because you can only disclaim a claim, the filing of a disclaimer amounts to an admission that the original claim is invalid. Throughout its brief runs this false premise (pp. 16, line 26; 17, line 10; 18, line 4; 20, lines 3, 8 and 14; 36, line 21; 41, line 3; 43, line 21; and p. 48, line 12).

Note that appellant cites no authorities to sustain its position on either point. Appellant has refused to discuss

or even to recognize the controlling cases (pp. 26, 83, *infra*) on qualifying disclaimers which hold that filing such a disclaimer is not an admission that the original claim was invalid. Instead, appellant quotes from the *Ensten v. Simon* case (pp. 18, 19), the *Union Metallic Cartridge* case (p. 21) and the *Hailes v. Albany* case (p. 21), which fit in class one of the Supreme Court's classification (p. 26, *supra*) and are not in point because there the claims had been held invalid by a court. They were not cases of qualifying disclaimers.

As to appellant's misconstruction of the Disclaimer Statutes, there is no need to repeat our discussion (pp. 31-43) of the qualifying disclaimer cases from the Supreme Court down, none of which have ever held that the Disclaimer Statutes only permitted disclaimer of whole claims. These cases recognize that by a qualifying disclaimer a patent owner may "*make disclaimer of such parts of the thing patented as he shall not choose to claim or hold by virtue of the patent*", *provided that the part retained "is a material or substantial part of the thing patented and definitely distinguishable from the parts claimed without right"*\* Appellant's misconstruction of the Statutes is simply out of step with the law, for certainly it is not the law that you can only disclaim a claim.

Looking now to the disclaimer, the part retained by Stadtfeld is definitely distinguishable from the parts disclaimed for the reason that *the part retained is the thing*

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\*U. S. Code, Title 35, Sections 65, 71, printed in appendix at page vii.

*originally claimed as fully and clearly illustrated in the drawings of the patent and fully and specifically described in the specification of the patent. It is any broad generic coverage that is disclaimed by making the claims specific, just as the Supreme Court says the Statutes permit (p. 26).*

The Court may wonder at appellant's frequent use (pp. 8, 14, 20, 22, 23) of the words "excind", "excinding" and "excision". We mention in passing that they are not used in the statutes and can mean no more than the word "disclaimer" in the statutes.

Now, turning to appellant's false premise to the effect that the filing of a disclaimer amounts to an admission that the original claims were invalid, the law clearly is otherwise. In many cases, as here, the disclaimer was filed out of an abundance of caution and not because there was any prior art that disclosed Stadtfeld's invention. As practical proof of the fact that there is no anticipating prior art, is appellant's own inability to leave the Stadtfeld invention and take up a prior art device. *The filing of a qualifying disclaimer is held by the courts to give rise to no inference or admission that the claims were invalid without the disclaimer*

In *Permutit Co. v. Wadham*, 13 F. (2d) 454 (C. C. A. 6), the Court said (p. 457):

"We do not understand that a disclaimer to avoid the supposed anticipating or limiting effect of some other publication is a confession that the patent would be void if the disclaimer were not made. *The patentee decides a question of policy; he may think*

that, although the supposed anticipation can be successfully met and defeated, a disclaimer will not affect the real value of this patent, and to make it will save trouble and expense and do no harm. *We see no reason why he is not at liberty, after the disclaimer as before, to deny the anticipatory effect of the other matter; and it has been so held. Manhattan Co. v. Helios Co., 135 F. 785, 802* \* \* \* “So far as this record shows, *the case was thoroughly appropriate for a precautionary curative disclaimer.*”

In *Nelson Mfg. Co. v. F. E. Meyers & Bro. Co.*, 56 F. (2d) 512 (C. C. A. 6), the Court said (pp. 512, 513):

“The motion to dismiss was based upon the proposition, advanced in argument here, that original claims 7 and 1, were, not only admitted to be invalid by appellee when it filed its disclaimers, but were shown to be so by the new references. Upon that basis it is contended that the bill should have been dismissed by the lower court because the infringing acts relied upon were committed before the filing of the disclaimers. *We cannot agree that Dunbar v. Meyers, 94 U. S. 187, 24 L. Ed. 34, the Packing Company cases, 105 U. S. 566, 26 L. Ed. 1172, and Collins Co. v. Coes, 130 U. S. 56, 9 S. Ct. 514, 32 L. Ed. 858, require the conclusion that the filing of the disclaimers was a confession that the original claims were invalid for anticipation. See Permutit Co. v. Wadham, 13 F. (2d) 454, 455 (C. C. A. 6), not reversed on this point in Permutit Co. v. Graver Corp., 52 S. Ct. 53, 76 L. Ed. 163.*”

Additional cases to the same effect are cited at page 83, *infra*.



7. AS TO FINDING No. 7—THE TRIAL COURT CORRECTLY FOUND THERE WAS “INADVERTENCE, ACCIDENT OR MISTAKE” AND NO WILFUL FRAUDULENT INTENT TO CLAIM MORE THAN HIS INVENTION AND THE DISCLAIMER WAS FILED PROMPTLY “WHEN” THE NEED BECAME APPARENT.

Appellant attempts several times in its brief (pp. 16, line 26; 36, line 21; 43, line 21; 41, line 3; 48, line 12) to use its erroneous, unsupported proposition that filing a disclaimer is an admission that the claim is invalid, to supply facts which are not in the record. One such instance is in the course of its argument about inadvertence, accident, mistake, etc. Appellant alleges (p. 36) that Stadtfeld and appellee knew of the O’Toole patent (Def. Ex. 4-E III. 727, discussed at p. v, *infra*) (p. 38); that they knew the O’Toole patent anticipates the original Stadtfeld claims; that filing the disclaimer was an admission the original claims were invalid; and therefore there was no inadvertence, accident or mistake about accepting the original claims and they must have been intentionally accepted with knowledge of their invalidity. Each allegation and the conclusion, as the trial court found, is untrue and easily shown to be so.

The disclaimer statutes may be employed whenever (1) through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than he should have, and (2) there is no unreasonable neglect or delay. These call for a finding on *intention* and *time*, and both are covered in Finding No. 7, which reads, “*when it appeared to plaintiff that through inadvertence, accident or mistake their language was of*

undue breadth, and permitted an interpretation *broader than was intended*". Here is a specific finding on the time and intention requirements of the statutes. In complete disregard of Finding No. 7, and without reference to it, appellant attempts the suggestion (pp. 9, line 13; 12, lines 12, 23; 39, line 19) that the lower court made no finding thereon. "Inadvertence, accident and mistake" and "intention" are treated together by the courts (*Van Meter v. U. S.*, 47 F. (2d) 192, 194 (C. C. A. 2, annotation 3) and the above quoted portion of Finding No. 7 shows the trial court considered both time ("when") and intention ("intended").

Appellant does not show wherein the prior art it cites (p. 36) anticipates the claims, and more important, assuming it did, it has not shown a single fact to indicate that Stadtfeld or appellee appreciated that such might be the case. There is no proof whatever that Stadtfeld or appellee had any intention to obtain or hold claims which read on the prior art.

The O'Toole reference (Def. Ex. 4-E, III) which it stresses (p. 38) was shown to Stadtfeld along with appellant's attorney Connor's letter (Def. Ex. 12, III. 884). Here occurs a very serious and absolute misstatement of fact by appellant when it says (p. 38, line 18) that its attorney, Connor, had reported "The pipe was not novel and patentable". The true fact is that Connor, who tried the present case, reported that in his opinion (III. 884) "there is a possibility of securing a patent". When Stadtfeld was shown the Connor report he read there that *Connor thought a patent could be obtained because*

O'Toole failed to show "a double-walled pipe in which each wall had a joint independent of the other. Both Line and O'Toole bring their walls together to present but one pair of telescoping members at a joint", (III. 884) and, he could have added, that *O'Toole rivets this joint so there is no slidability. In other words, the very slidable, double-walled pipe which Stadtfeld's patent specification and claims have always covered was admitted by appellant's attorney not to be found in O'Toole.*

Clearly, on the record there is nothing about this patent, or any of the others, to put Stadtfeld or appellee on notice that the claims which the Patent Office granted should be narrowed by disclaimer. The showing of any "fraudulent or deceptive intention", an essential to appellant's argument, is completely lacking.

To bolster its erroneous contention appellant brings in (p. 36, line 21) its unsupported and untrue premise that filing the disclaimer was an admission the original claims were invalid. Unable to find the element of intention in the record, appellant seeks to imply it from the filing of the disclaimer. The authorities at page 51, supra, and page 83, infra, completely blast this contention.

Another unjustified liberty which appellant takes is in the citation of alleged authorities (pp. 36, 37) as to what is a reasonable time for filing a disclaimer.

The general rule is, "*Delay begins whenever the patentee becomes aware that he has claimed more than he has invented or described.* In cases where the excess is not apparent at once upon the inspection of the patent by the patentee, the allowance of his claim by the Patent

Office raises such a presumption in its favor that *he may rely on its validity until a court of competent jurisdiction decides that it is broader than his real invention.*"

*Robinson on Patents*, p. 284.

Not a single one of the cases cited by appellant (pp. 36, 37) involved a qualifying type disclaimer. They all were cases where the claims had been held invalid by a court (Class I of Supreme Court classification, p. 26, *supra*). If appellant had turned to the cases dealing with qualifying type disclaimers it would have found that the courts consider such a disclaimer is not unreasonably delayed even when made "*after decision on appeal*".

"The view we take is that the matter of disclaimer was within the discretion of the patentee to be reasonably exercised—'*a matter of policy*' (*Permutit Co. v. Wadham*, 13 F. (2d) 454, 457 (C. C. A. 6)), and we think there was sufficient doubt as to whether claims 3 and 4, as originally written, were anticipated to justify the seeming delay. *Walker on Patents* (2d Ed.), Sec. 255" (*Metropolitan v. Cleveland*, 36 F. (2d) 477, 479 (C. C. A. 6)).

Certainly, Stadtfeld's disclaimer filed before trial is as timely as one filed after decision on appeal. We know of no case involving a qualifying type disclaimer where a court ever found there had been unreasonable delay or wilful fraudulent intention.

Appellant is probably technically estopped under Rule 19 (6) of this Court from making any contention in its brief about there being no inadvertence, accident or mistake, or any fraudulent or deceptive intention, because its

point I-e (II. 617) only raises the question of unreasonable neglect and delay in filing the disclaimer.

We submit that the trial court's finding No. 7 completely and correctly sets forth the necessary fact findings on inadvertence, accident or mistake without any fraudulent or deceptive intention and without unreasonable delay; and that appellant's complete intermingling of these in its argument (pp. 36-39) further rebuts appellant's statement (pp. 9, 12, 39) that a finding was not made on each essential.

This completes discussion of appellant's arguments at large attacking Findings No. 7 and 9. We turn now to its other random arguments and discuss these in relation to the findings we think they are intended to attack.

**8. AS TO FINDING No. 8—THE DISCLAIMER DID NOT MAKE THE CLAIMS COEXTENSIVE WITH ANY REJECTED CLAIMS NOR AMOUNT TO RECLAIMING REJECTED SUBJECT MATTER, AND THE COURT BELOW CORRECTLY FOUND THIS TO BE THE FACT.**

The contention by appellant (p. (8) 13; (4) p. 16; (b) p. 17; p. 40) that Stadtfeld intended to omit from the patent franchise and is estopped from having any claim directed to the details of construction of the outer and inner tubes is without any basis in the record and is not the fact. We have to assume it is Finding No. 8 (supra, p. 23) which appellant attacks. Appellant, without any authorities in point, seeks to build this argument on cancelled claims 3, 4, 5 and 8. It does not point out to the court that rejected claims 3, 4 and 5 (III. 694) never did contain one of the essential limitations, namely, slidability, which affected

the allowance of the three claims in suit. Similarly, appellant does not point out to the court that claim 8 (III. 698) contained only two elements, the inner and outer tubes and never contained the slidability functional limitation, nor the third element, insulation. *The cancelled claims were for entirely different combinations*, and this Court has held that in such a case any estoppel extends no further than to those cancelled combinations (*Johnson v. Philad*, 96 F. (2d) 442, 444, 2nd column (C. C. A. 9) (printed in appendix p. ix)). For appellant's argument to have any basis, the facts would have to be different, namely, either claim 3, 4, 5 or 8 would have had to call for the three elements of the patented claims plus the qualifying limitations of the original claims and of the disclaimer. A glance at the file wrapper (III. 694, 698) shows claims 3, 4, 5 and 8 never had such content. This blasts appellant's fact contention on this point. The same erroneous contention in a slightly different dress is discussed under point 11 at page 81, *infra*.

Furthermore, the impression appellant's argument (p. 44, line 1) tends to create is not the law. The cancellation of a claim during prosecution is not an admission that the structure set out in the cancelled claim is old in the art. "It is a declaration that that which is not claimed is *either* not the patentee's invention, or, if his, he dedicates it to the public" (*Miller v. Bridgeport Brass* case, 104 U. S. 350, 352). *He only concedes that he does not choose to assert further his claim to a monopoly on the particular combination of those cancelled claims*. So, examining claims 3, 4, 5 and 8 we see that Stadtfeld dedicated to the public *only the exact combination they describe*.

This is the substance of the *Wilson v. Union Tool* case quoted from on page 40 by appellant and is good law, but that case does not support appellant's erroneous contention that the three element disclaimer claims with the two tube elements limited to having male and female ends are not valid claims. *At no time during prosecution of the case did Stadtfeld ever acquiesce in the rejection of a three element claim with the slidability limitation.* The structures relinquished in claims 3, 4, 5 and 8 omit the features of slidability and insulation which are an essential in the three patented claims (compare *Johnson v. Philad.*, supra).

As granted by the Patent Office, claims 1, 2 and 3 were for three elements with the slidability limitation. There was no limitation on the form of the tubes, therefore the original generic scope of the claims would have covered male and female ends or both male ends or any kind of ends. The disclaimer voluntarily limited the tubes to the specific form having male and female ends. *The important thing is that the claims are not like any claim cancelled during prosecution.* Thus, appellant's pretended argument falls on both the facts and the law and no error whatever is shown in the trial court's finding No. 8 (I. 51).

**9. AS TO FINDING No. 22—THE CLAIMS ARE FOR A PATENTABLE COMBINATION AND NOT AN AGGREGATION, AS THE TRIAL COURT CORRECTLY FOUND.**

Without any heading (p. 40, last paragraph) and without mentioning that the trial court found otherwise, appellant throws out a suggestion that the claims are invalid because for "an aggregation and not a patentable inven-

tion''. There is no such rule as appellant seeks to imply, that all elements must be interdependent (See *Walker on Patents*, (Deller Ed.) p. 216). Appellant ignores the fact that Mr. Connor, appellant's former counsel in this case, had no difficulty in seeing a patentable combination in the new arrangement of twin pipes with slidability through independent joints and the intervening insulation to keep the pipes spaced apart and the inner one cooled (III. 884). We know of no better discussion on the question of aggregation than in *Sachs v. Hartford*, 47 F. (2d) 743, 748 (C. C. A. 2) which fully sustains the District Court's finding No. 22 (I. 54).

“We have not dealt with the defendant's argument that the first patent is for an ‘aggregation’. Frankly, we are unable to attach a definite meaning to that word. The notion that the parts of an invention must co-operate is certainly very persisting in the patent law, and it must correspond to some underlying idea. So far as it means that the whole complex claimed must be a unit in use, each part of which shall be necessary to the common result, we can understand it. So far as it rests upon an implied reference to mechanics, that is, that each part must give or take a strain, *it seems to us a false lead*. The test is more practical than that because inventions are to answer human needs, and the elements may be mechanically inert. *The cooperation of the means necessary to create an invention is to be measured by the purpose to be fulfilled, not by the interaction of the parts*. Each factor must indeed be a condition to that result, but the whole may be a mere assemblage; *the cooperation between them all may be no more than their necessary presence in a unit which shall answer a single*



*purpose.* Therefore, we can find little advantage in a discussion of what is or what is not an 'aggregation'. In patents, as in other branches of the law, the question is of the interests involved; inventions depend upon whether more was required to fill the need than the routine ingenuity of the ordinary craftsman. Such a standard is no more of a will-o'-the-wisp than others which the law adopts, reasonable care, reasonable notice and the like; the effort is to fix that standard by recourse to average propensities, dispositions and capacities. Any attempt to define it in general terms has always proved illusory; it is best to abandon it."

10. AS TO FINDINGS 8, 11, 12, 13, 14, 15, 16 AND 22—THE PATENTED INVENTION WAS NOVEL AND IS NOT DISCLOSED IN THE PRIOR ART AS THE TRIAL COURT CORRECTLY FOUND.

Appellant makes no reference to the trial court's findings 8, 11, 12, 13, 14, 15, 16 and 22 (I. 51, 52) attacked by its arguments (pp. 41-47). The fallacies of its arguments and the manifest correctness of these findings are easily shown.

The record in this case demonstrates beyond doubt that Stadtfeld's flue pipe was a totally new combination. The novel features were reviewed at page 15, *supra*. At the trial a total of 21 prior art items were offered in evidence by appellant in an attempt to anticipate the patented invention or show lack of invention. They may all be read, and nowhere can there be found any teaching of Stadtfeld's discovery of how to make a successful flue pipe. *No one before Stadtfeld, although the means were at hand and the need was great, had had the mental picture of a*

*new arrangement of pipes and insulation combined to function on a new principle and produce a new result.* No one before had taken the mental leap to this new arrangement and combination. This is covered in findings 11 and 16 as follows:

“11. Stadtfeld, the patentee of the patent in suit, was the first in the art to create a flue pipe structure containing the combination defined in each of the three claims in said patent.”

“16. The flue pipe art is an old art, but the invention of Stadtfeld set forth and claimed in Patent No. 2,013,193 is substantial and important. One of the principal merits of the invention is its simplicity. It was an arrangement of old elements which produced a new result. It has solved a problem of long standing in that art and has gone into wide and successful commercial use.”

Now that Stadtfeld's invention has been disclosed to the world it is an easy task to assemble every suggestion in this and other arts to create a suspicion of a general lack of novelty in what Stadtfeld did. This can be done in the case of any patented invention.

“The industrial and scientific problems which face mankind are being attacked all over the world by busy, inventive minds from the most varied points of view. When some lucky inventor has been successful in solving the problem and (whether for the purpose of action or otherwise) the records of past failures or incomplete success are searched, it is common to find that suggestions or adumbrations of each of the various steps by which he has achieved his result are to be found in some one or other of the works of

those who have gone before him, and when such records are selected from a mass of antecedent publications and put in an isolated form before a court, there is a danger of their giving rise to a suspicion of a general lack of novelty in the successful invention. But *it must be remembered* that these alleged prior publications are the product of a selection made with a knowledge of the successful invention, and that probably hundreds of proposals equally promising, but which point in wholly different directions, have been rejected in the search by reason that they do so.”

*Minerals Separation, Ltd. v. The British Ore Concentration Syndicate, Ltd., et al.*, 27 R. P. C. 53.

“The defendant assembles every similar device, description, or suggestion in the particular art not only, but also in analogous, and even in remote arts. Everything which has the least bearing upon the subject is brought in and arranged by a skillful expert in an order of evolution which resembles most closely the invention which is the subject of attack. Having thus reached a point where but a single step, perhaps, is necessary to success, and *knowing from the inventor exactly what that step is*, the expert is asked if the patent discloses invention, and honestly, no doubt, answers in the negative. There is always the danger, unless care is taken to divest the mind of the idea added to the art by the inventor, that the invention will be viewed and condemned in the light of ascertained facts. With his description for a guide, it is an easy task to trace the steps from the aggregation to the invention. When it is remembered that before Sir Humphrey Davy made his safety-lamp, wire gauze, and lanterns provided with perforated tin cylinders, were well known, it seems, in the light of the present,

as if the idea of substituting the gauze for the perforated tin, being apparently so simple, might have occurred even to a skilled mechanic. So, too, moving the eye from the head to the point of a needle seems, in this age, but a trifling thing; and yet, to the inspiration of genius which suggested these changes we are indebted for two inventions of inestimable value.”

*Johnson v. Forty-Second Street, M. & St. N. Ave. R. Co.*, 33 F. 499, 501.

*Indeed, it is impossible to reconcile the important recognition given Stadtfeld's invention by the art, in fact by appellant itself in its own advertising, with the contention that he discovered nothing new.*

*Appellant's advertising is particularly significant because it stresses as novel the very features of combination which are lacking from the prior art and which Stadtfeld only discovered after years of labor with the flue pipe problem.* Here are some samples of these advertisements by appellant-defendant which herald the novelty, efficiency, safety and lower installation cost of the flue pipe in suit:

“*A new type of gas vent and flue pipe*” (Def. Ex. 14A, III. 886).

“*New in design and construction, yet old in principle, this pipe is now offered to the trade as being the most efficient, durable and safe pipe on the market,—not ‘just another pipe’* (III. 885).

“*Metalbestos is the most efficient pipe because of its high insulating value, there being one-half inch of asbestos around inner pipe and fittings.*

“*It is safer because of its always cool outside surface which eliminates fire hazard, because its crimped*

*opposite ends of inner and outer pipes and fittings make for leak-proof connections, and because the outside galvanized iron jacket protects the insulation against disintegration through exposure to moisture.*" (Def. Ex. 15A II. 885).

"It is *easily assembled* without the use of cement or other materials." (Def. Ex. 15B III. 887).

"Metalbestos is *without equal* as a pipe for venting gas appliances. The *use of aluminum pipe as a gas vent is not a new idea* as it has been used for years without failure from a corrodible standpoint. *Its shortcoming has been that due to its high rate of heat conductivity it has caused such rapid chilling of the products of combustion that condensation was excessive and draft conditions poor. We have taken advantage of the durability of aluminum and have overcome the obstacle of excessive heat loss by insulating the aluminum pipe comprising the inner tube of Metalbestos. The only real way to prove that it is all that we claim it to be, is to try it out on some of your jobs. You will be more than pleased with its performance and its low cost of installation.*"

(From one of 1000 letters to the trade—May 15, 1934—Def. Ex. 18, III. 897).

"Metalbestos Gas Vent and Flue Pipe, has *won such instant and hearty approval in all sections of the country. Our claims as to its superiority over all other commonly used gas vent pipes* are amply borne out and we know that a few trial installations will convince you of *its many advantages, including lower installed cost.*"

(From letter Aug. 1, 1934 to the Trade—Def. Ex. 18, III. 898).

“Payne-A-Vent\* *has been accepted by the trade as being, by far, the most efficient, durable and easily installed pipe on the market. The efficiency of Payne-A-Vent, from a draft standpoint, is insured due to the high rate of heat conductivity of the aluminum plus the provided insulation. The rapidity with which the inner tube heats up and conveys the heat from one section of aluminum pipe to the other, provides a hot stack immediately. This condition is greatly accelerated due to the surrounding insulation, which prevents the radiation of heat from inside the pipe. A hotter stack, more immediate and perfect draft and consequently quicker and better combustion of fuel is obtained through the use of Payne-A-Vent over any other commonly used type of gas vent or flue pipe on the market.*”

(From Bulletin distributed by the thousands—Pl. Ex. 5 II. 640).

Such praiseworthy statements as these by the infringer which call attention to the radical novelty of Stadtfeld’s invention and its ready acceptance by the trade to fill “*a long-felt want*” cannot be overlooked. Today it is filling a substantial per cent. of the market (II. 270).

In *Hiler Audio Corp. v. General Radio Co.*, 26 F. (2d) 475, 478 (Mass.), (no appeal), the court had before it a device similar to the one in suit, in that the device was made up from elements all old in the art, and the defendant, caught red-handed, sought to invalidate the patent. Judge Brewster held the patent valid and infringed. On the point of defendant’s advertising he said (p. 478):

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\*Appellant’s new name for the flue pipe.

“*In its advertisement it would have the public believe that the infringing device is unique in design and performance. It also, in its advertisements which it circulated, enlarged upon the advantages of the infringing device. These advantages were substantially the same as those mentioned by Hiler in his application. Such imitation ought to be given weight as evidence of what the defendant thinks of the patent, and persuasive of ‘what the rest of the world ought to think’.* Kurtz v. Belle Hat Lining Co. (C.C.A.) 280 F. 277, 281.”

And similarly in *Mallinckrodt Chemical Works v. E. R. Squibb & Sons*, 6 F. Supp. 173, 175 (Mo.), affirmed 69 F. (2d) 685 (C. C. A. 8), the defendant’s statements made in advertisements were held to outweigh its later plea of invalidity where (p. 175):

“\* \* \* it appeared from the evidence that the defendant advertised its seal as an improvement and placed upon its can a statement that it too had applied for a patent.\* The defendant, under such circumstances, could hardly be heard to dispute the validity of plaintiff’s patent. *David et al. v. Harris*, 206 Fed. 902; *Hiler Audio Corporation v. General Radio Co.*, 26 Fed.(2d) 475.”

The trial court found:

“12. The combinations defined respectively in claims 1, 2 and 3 of the Stadtfeld Patent No. 2,013,193 are each a substantial and meritorious advance over

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\*Appellant Payne, although refusing to go through with its agreement to patent the Stadtfeld invention, did nevertheless mark its pipe and literature with “PAT. APPLIED FOR” (Exh. 14 A III. 885) when in fact appellant had no patent pending.

anything found in the art prior to such patent and each constitutes subject matter which required inventive genius to produce.”

Appellant’s brief (pp. 41-46) refers to but twelve of the many prior art items presented to the lower court. The remainder may be disregarded. As to the prior patents the trial court found:

“13. Each of the patents offered in evidence by the defendant as prior art with respect to the Stadtfeld Patent No. 2,013,193 fails to disclose one or more of the elements of the combinations respectively defined in the claims of said patent, or any equivalent thereof, and fails to show any prior invention, knowledge, use, or patenting of the combinations respectively defined in said claims.” (See also finding #15—I. 52.)

Appellant argues that Stadtfeld did not discover or teach anything that was not as well disclosed by this prior art. It is only necessary to examine this art to see at once that this is not true. *A most significant thing about appellant’s discussion of the prior art is its complete inability to pick out any reference and say: “There is the Stadtfeld invention”.* Instead, *appellant is only able to approach the Stadtfeld invention by a mosaic of the prior art,—by taking a little bit from this reference, a little bit from another, and so on.* After several pages (pp. 44-46) of discussing what parts it will take from the various patents to make up the Stadtfeld invention, appellant ends up by admitting (p. 46, line 31) that what it proposes is for the Court to make a “selection of the preferred form of elements from old prior art structures”.



Such attempts at piecemeal anticipation of valuable inventions have never been approved by this Court or any other.

*“The defense offered is a mosaic defense and as was said by this court in Craft-Stone, Inc. v. Zenitherm Co., Inc., 22 F.(2d) 401, ‘The patentee invented a new and useful product, and it is not permissible for an infringer to go to the prior art and defeat the patent by selecting the various elements of the patentee’s process from different patents, bring them together, and say that this aggregation anticipates. Knowledge after the event is always easy, and problems once solved present no difficulties. Loom Co. v. Higgins, 105 U. S. 580, 26 L. Ed. 1177; Diamond Rubber Co., etc. v. Consolidated Rubber Tire Co., 220 U. S. 428, 31 S. Ct. 444, 55 L. Ed. 527.’ ”*

*Atlantic Refining Company v. James B. Berry Sons’ Inc., 40 U. S. P. Q. 2, 6 (C. C. A. 3) (Decided Dec. 21, 1938).*

*“It is to be borne in mind that the prior art here relied upon consists entirely of patents, and that when it is sought by means of prior patents to ascertain the state of the art, ‘nothing can be used except what is disclosed on the face of those patents. They cannot be reconstructed in the light of the invention in suit, and then used as a part of the prior art.’ ”* (Citing cases).

*J. A. Mohr & Son v. Alliance Securities Co., 14 F. (2d) 799, 800 (C. C. A. 9).*

See, also, *Stebler v. Riverside, 205 Fed. 735, 738 (C. C. A. 9).*

The present problem facing this Court in examining the prior art is well expressed in *Railroad Supply Co. v. Hart Steel Co.*, 222 Fed. 261, 273, 274 (C. C. A. 7):

“Invention of a combination does not lie in gathering up the elements that are employed, but *consists in first conceiving that a new and desirable result may be attained by bringing about a relationship of elements which no one has before perceived* and then going forth to find the things that may be utilized in the new required relationship. *In an old and well-developed field the apparent simplicity of a new device is often the highest evidence of inventive genius.* So far as human minds are able, *judges should exclude from view the disclosure of the patentee, should regard the patentee’s problem as of a time antedating the application, and should therefore not too readily accept the ex post facto wisdom of the bystander. Prior art structures are to be examined in view of the purposes and laws of such structures. It is not enough that a prior art device approach very near the idea of the patent in suit; it must so clearly disclose the idea that it would be apparent to a mechanic of ordinary intelligence who was not examining the device for the purpose of discovering in it the idea of the patent. For, if he already had that idea, he would not be getting it from the prior art device, but from his own imagination or some other source.*”

The Court of Appeals for the Third Circuit also points out the great care which that court exercises with prior art patents:

“Now not only does *every prior patent fail to show Peiler’s combination, not only can such patents be used without infringing Peiler’s claims, but it is clear*

that the glass art, which was frantic to get some machine to free them from Owens' domination, saw nothing in any of these prior patents, either in instruction or even suggestion, to enable the art *to discover such a path as Peiler hewed out*, much less, even by implication to suggest such a path. And where an art, eager for relief, found in these moribund patents nothing to meet that suggested solution, *it is safer to rely* evidentially on the then judgment, attitude and conduct of the glass trade, rather than *on the post litem testimony of experts, the contentions of infringers*, and the theoretical construction that often *tempts courts to create out of lifeless patents* an imaginary machine on paper which a working art could not do in steel."

See *Hartford-Empire Co. v. Hazel-Atlas Glass Co.*,  
59 F. (2d) 399, 413.

With one more short quotation from the Supreme Court bringing out a rule which this Court will find applicable as it examines the prior art in its relation to Stadtfeld's invention, we can pass on to that art.

"Where the thing patented is an entirety, consisting of a separate device or of a single combination of old elements incapable of division or separate use, the respondent cannot make good the defense in question by proving that *a part of the entire invention is found in one prior patent*, printed publication, or machine, and *another part in another*, and so on indefinitely, and from the whole or any given number expect the court to determine the issue of novelty adversely to the complainant. *Bates v. Coe*, 98 U. S. 31.

"Common justice forbids such a defense, as it would work a virtual repeal of so much of the Patent

Act as gives to inventors *the right to a patent consisting of old elements*, where the combination itself is new and produces a new and useful result. *New elements in such a patent are not required*, and if such a defense were allowed, not one patent of the kind in a thousand of modern date could be held valid. Nor is such a defense consistent with the regulations enacted by Congress in respect to the procedure in litigations in respect to patent-rights.’’

*Parks v. Booth*, 102 U. S. 96, 104.

Of all the art referred to in appellant’s brief, only one patent (Savage) and one prior use (the abandoned, outlawed Los Angeles flue) have to do with flue pipe. The other items are entirely non-analogous art from which appellant plucks a piece of insulation or a piece of tubing with a crimped end, etc., in its endeavor to construct the Stadtfeld invention from these lifeless, non-analogous patents.

*Savage Patent* (Exhibit 4-C, III. 718). This patent was issued in 1893, about forty years before Stadtfeld made his invention. The device never was used and the reason why will be made clear by examining the drawings (III. 718). The inner tubes are spaced apart *vertically* from each other between sections and do not form a continuous walled passage, with the result that *condensate from the gases would flow directly into the exposed insulation* at the separated tube ends, and cause it to fall and leave an open space through which *the burned poisonous gas would flow into the room* (II. 571). For this reason alone *it would not pass inspection* of any building authorities (II. 570). Another reason it is impractical and won’t pass

inspection is the lack of connection between one section of inner tube and the next section (II. 571). The flue is assembled on the job, at which time the insulation is tamped in around the pipe without anything to assure centering of the inner tube, or that an equal amount will be tamped in on all sides. Practically, *the inner tubes would not be perfectly aligned, and the gases of combustion would exhaust into the insulation at each disaligned joint* (II. 569). Another reason it is impractical and won't pass inspection is the *lack of durability* (II. 571). Once the insulation is saturated with condensate it shrinks into a smaller volume. This would leave the inner pipes entirely unsupported and the net effect would be to disrupt the inner conduit for the poisonous flue gases. Appellant's assumption (p. 43) that the inner tube is slidable in the insulation is incorrect and departs from the record because the flange 2 (Fig. 1) positively prevents it (II. 569).

**The Abandoned "Los Angeles" Flue (Def. Ex. 1, I. 86).**

Depositions were taken to establish three installations of this obsolete, outlawed Los Angeles flue. The trial court found:

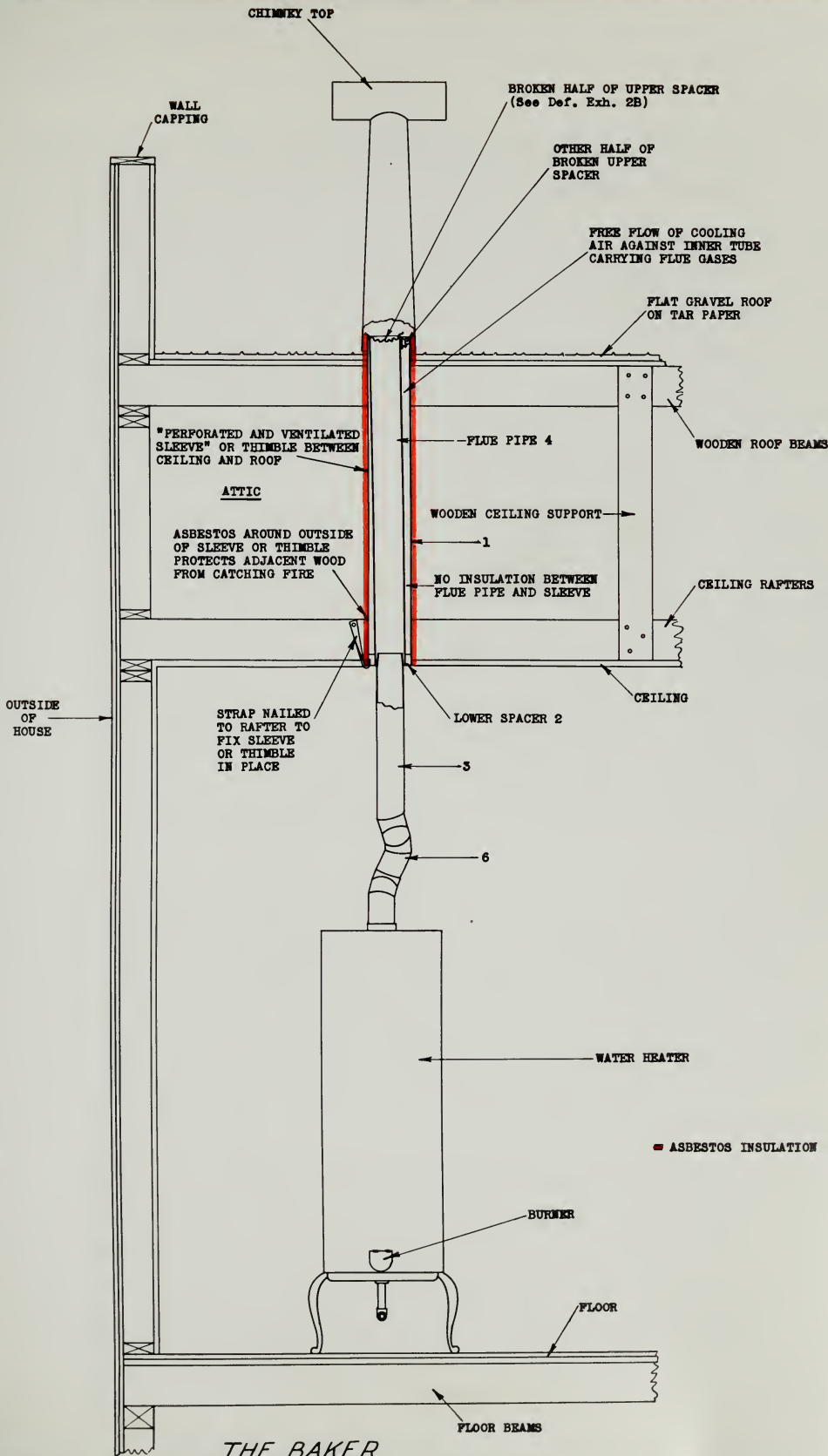
"14. Each of the alleged prior uses by Baker, Shearer, and Evans offered by the defendant as prior uses with respect to the Stadtfeld patent No. 2,013,193 fails to disclose one or more of the elements of the combinations respectively defined in the claims of said patent, or any equivalent thereof; and fails to show any prior invention, knowledge, use or patenting of the combinations respectively defined in such claims."

Appellant refers now (p. 46) only to the Baker installation. The depositions were intended to show what had been the practice in Los Angeles for some twenty years before that city, about 10 years ago, banned any further like installations (II. 372). *Today these "Los Angeles" flue installations are outlawed, yet the flue pipe sold by appellant is lawful and sold with great success. We cannot escape the conclusion that the old Los Angeles structure is not like the patent in suit.*

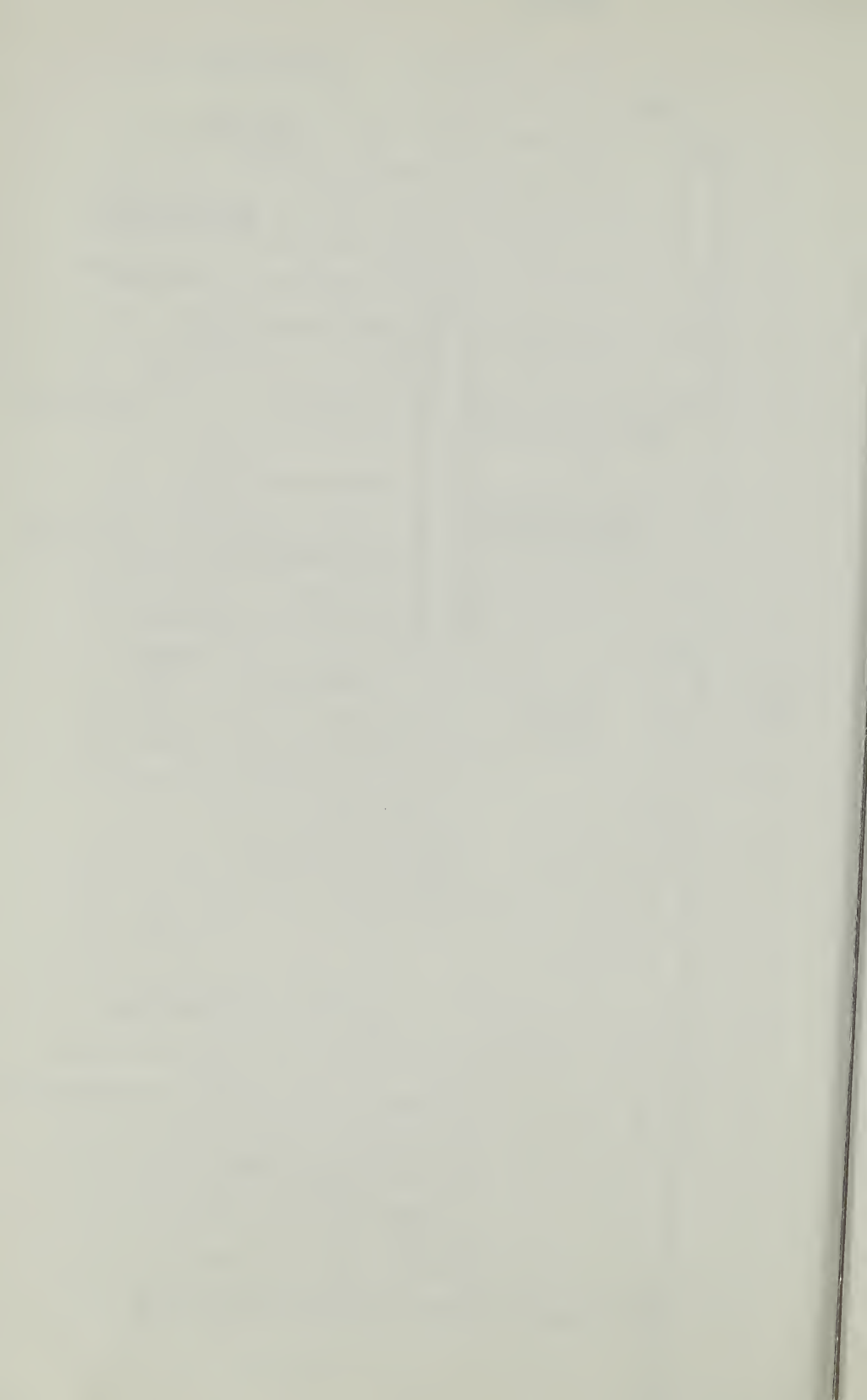
We have prepared a diagrammatic showing of the Baker installation, which was simply a one-tube flue pipe 4, passed through "a perforated and ventilated sleeve or collar" 1 (L. A. ordinance 1924, Def. Ex. 9, (III. 799), no longer in force). The "perforated and ventilated sleeve or collar", also known as a thimble, called for by the ordinance, extended only between the ceiling and the roof and had an asbestos covering on the outside. It was fixed in place by straps nailed to a rafter in the attic.

*There was no insulation placed around the portion of the flue pipe where it passed through the thimble, or at any other point.* On the contrary, all the testimony establishes that there was to be a *free flow of cooling air against the flue pipe* throughout its length, as well as through or close to combustible materials. The Los Angeles ordinance then called for ventilation between flue and thimble, —the very antithesis of Stadtfeld's teaching. There was no attempt whatever to insulate the flue pipe as Stadtfeld did, either where it passed through the thimble or where it was exposed in the room below.

The net result of such a construction was a flue pipe which could not attain high temperatures (II. 573). This



*THE BAKER  
INSTALLATION*





meant that the flue pipe, lacking any insulation whatever applied to the flue pipe itself, could not operate efficiently.

When Baker removed the fixed thimble 1 and section of flue pipe 4, the latter was "heavily coated with soot" on the inside (L. A. Tr. 91), which meant that the flue temperatures had been too low to establish for the burner the proper conditions for combustion, and a dangerous "floating flame" had been the result (II. 573). This soot deposit shows "it could not have been functioning in the proper manner or we would not have that carbon deposit." (II. 573).

"It indicates that the combustion of the burner of whatever appliance this was hooked to was not functioning properly; in other words, there was not a proper draft to insure proper combustion; the only time that you *should or will get a sooty condition like this* from an appliance burning gas is *when that floating flame prevails where you are not getting the proper combustion*" (II. 573).

The uncontradicted testimony establishes that the Los Angeles flue did not give a satisfactory draft; that it was hazardous and dangerous causing carbon monoxide to be present in excessive quantities; and that if the joints are not tight there is no place for these gases to go but out into the room (II. 513). No wonder then that the authorities banned it from use.

There is no suggestion in the Baker installation of any construction like the patent in suit. In Baker there was no concept of having a plurality of sections joined together to form a twin-tube, insulated flue pipe extending from appliance to roof. *There was no concept of insulating*

*the single flue pipe.* The operating theory of this Los Angeles flue is the very antithesis of Stadtfeld's concept. Stadtfeld conceived a flue pipe construction that keeps the flue pipe throughout its length *as hot as the gases passing through it can possibly heat it.* The Los Angeles flue cools the flue pipe to as low a temperature as the free flow of air against it can effect. The Los Angeles device did not embody any of the features which make the Stadtfeld invention a success.

*“A device which does not operate on the same principle cannot be an anticipation.”*

*Los Alamitos Sugar Co. v. Carroll*, 173 Fed. 280, 284 (C. C. A. 9).

This obsolete Los Angeles flue was a failure and obviously is not the same as the lawful successful Stadtfeld flue, or appellant would still be making and selling it, as it did for many years and in great quantities before it became outlawed.

Appellant's reference (p. 45) to its bulletin (III. 903) suggesting joints to shed moisture only goes to emphasize the novelty of Stadtfeld's invention. Appellant had made the Los Angeles flue for years, it knew when it became outlawed and that for years after there was a feverish search for a new metal flue pipe that would take its place. It knew about male and female joints, yet it never occurred to appellant to put all the parts together the way Stadtfeld did so successfully.

*“Prior patents, none of which solved the problem, can have no effect in anticipating, qualifying, or defeating the claims for patent protection of those*

whose subsequent effort produced success. Consolidated Window Glass Co. v. Window Glass Machine Co. (C.C.A.) 261 F. 362.”

*Babcock & Wilcox Co. v. Springfield Boiler Co.*, 16 F. (2d) 964, 969 (C. C. A. 2).

This completes a discussion of the only flue pipe art cited by appellant. The remaining art is non-analogous if for no other reason than the fact that it is not flue pipe and *cannot be used as flue pipe without complete reconstruction to make it over from what it is*. But this would not be proper, as this Court has repeatedly held patents “cannot be reconstructed in the light of the invention in suit, and then used as a part of the prior art.” *J. A. Mohr & Son v. Alliance*, 14 F. (2d) 799, 800 (C. C. A. 9). See also *Stebler v. Riverside*, 205 F. 735, 738 (C. C. A. 9). And yet that is what appellant attempts. This non-analogous paper art is not relevant and is discussed in the appendix under the respective art classifications to which each item relates. The O’Toole and Meade patents with which appellants take so many liberties (pp. 42, 43), are admittedly not flue pipes nor adaptable for flue pipe use. Their lack of pertinence is shown completely at pp. iii, v of the appendix.

#### **The Non-analogous Paper Art.**

**Two Patents Show Steam Pipe Covering Materials**

(See page i of appendix).

Hammill No. 311,750 (Def. Ex. 4-A, III. 711)

Aldrich No. 340,691 (Def. Ex. 4-B, III. 714)

**One Patent Shows a Thimble**

(See page iii of appendix).

Meade No. 1,428,294 (Def. Ex. 4-F, III. 730)

**One Patent Shows an Underground Conduit**

(See page iv of appendix).

Harvey No. 534,473 (Def. Ex. 4-D, III. 722)

**One Patent Shows a Water Pipe**

(See page v of appendix).

Welch No. 1,927,105 (Def. Ex. 4-G, III. 735)

**Four Patents Show Hot Air Pipe**

(See page v of appendix).

O'Toole No. 878,014 (Def. Ex. 4-E, III. 726)

Bradbeer No. 390,438 (Def. Ex. 6-A, III. 780)

Line No. 690,744 (Def. Ex. 6-C, III. 787)

Line No. 696,059 (Def. Ex. 6-D, III. 790).

We respectfully submit that in no respect has appellant shaken the manifest correctness of the District Court's validity and invention findings Nos. 11, 12, 13, 14, 15, 16 and 22. (I. 51) *The prior art references cover the efforts of the skilled men in this art for a period of forty years preceding Stadtfeld's discovery. The failure of them all to make the invention demonstrates that what Stadtfeld did was in fact obvious to no one until he got the happy thought of his new combination. What he did went counter to the prior teachings in the flue pipe art. Appellant's effort to spell the Stadtfeld invention out of obsolete, prior art structures by a process of interpretation and expansion defeats itself. Its own conduct in making a*

“Chinese copy” of the Stadtfeld pipe instead of the prior art defeats it. Its advertising (supra, p. 64) heralding the novelty of the very features which distinguish Stadtfeld from the prior art defeats it. All appellant has done is what this Court refused to sanction in *Stebler v. Riverside*, 205 F. 735, 738:

“True, we may pick out one similarity in one of these devices, and one in another, and still one in another, and by combining them all, anticipate *the inventive idea* expressed in the Strain patent, but *the combination constituting the invention is not found in any one of them.* \* \* \* It is accordingly held that the defense of anticipation is not sustained.”

*Appellant's exact copying of the Stadtfeld structure and its inability to adopt any of the prior art devices in lieu of the invention in suit*, makes applicable as if it were written by the Supreme Court for this very case, the following language:

“The prior art was open to the Rubber Company. That ‘art was crowded’, it says, ‘with numerous prototypes and predecessors’ of the Grant tire, and they, it is insisted, possessed all of the qualities which the dreams of experts attributed to the Grant tires. *And yet the Rubber Company uses the Grant tire. It gives the tribute of its praise to the prior art; it gives the Grant tire the tribute of its imitation as others have done.* And yet the narrowness of the claims seemed to make legal evasion easy. Why, then, was there not evasion by a variation of the details of the patented arrangement? Business interests urged to it as much as to infringement. We can find no answer except that given by the Tire Company: ‘The patented organization must be one that is essential. *Its use in*

*the precise form described and shown in the patent must be inevitably necessary.'''.*

*Diamond Rubber Co. vs. Consolidated Tire Co., supra.*

Stadtfeld's combination is of a type clearly recognized in law as patentable, as the trial court found (Fdg. 12, I. 51).

The gas clothes dryer held patentable in *Judelson v. Hill*, 18 F. (2d) 594, affirmed 22 F. (2d) 262 (C. C. A. 2), on its facts parallels closely the present one. There had long been "a real problem in the art. Judelson made a number of attempts. Finally he discovered the combination. \* \* \* This idea and arrangement of a box with baffles was new in the art. *It was a scientific arrangement of old elements, which produced a new result.* \* \* \* it was the result of Judelson's thought and experiment. \* \* \* The Judelson heater also met with immediate commercial success." There, as here, defendant persisted in making the patented structure instead of the prior art. "It was the adaptation of various elements, old in themselves, but in a new combination, in which these old elements function differently and produce a new result. \* \* \* This was new and it worked. \* \* \* The demand and the money reward for a discovery meeting the demand had been present for some time. Just why, if this was merely a mechanical substitution, available certainly to defendant as well as to plaintiff, defendant should wait until what has been said to be the new idea of Judelson came upon the market, is not plain. \* \* \* Where a patent has been substantially copied, the Court should not be too astute to upset that patent. \* \* \*"

Many similar decisions of this Court can be found which held invention in a combination of old parts which in their new combination produce a new result and function differently (*Stebler v. Riverside*, 205 Fed. 735, 738 (C. C. A. 9); *Reinharts, Inc. v. Caterpillar Tractor Co.*, 85 F. (2d) 628, 635 (C. C. A. 9); *Mohr v. Alliance*, 14 Fed. (2d) 799 (C. C. A. 9); *Walker on Patents* (Del. 6 Ed.) p. 147. These are very different from the *Ray v. Bunting* case relied on by appellant (pp. 17, 47) because there there was no new result or function from the combination.

**11. THE STADTFELD ORIGINAL CLAIMS 1, 2 AND 3 AND CANCELLED CLAIMS 3, 4, 5 AND 8 ARE NOT PRIOR ART AND CANNOT BE USED TO ANTICIPATE THE PATENT.**

Lacking any relevant prior art to support its appropriation of the invention, appellant in desperation attempts to manufacture some prior art of its own. However, there is no justification in law or fact for this attempt in appellant's brief to assert (pp. 16, 41, 43) that the disclaimer claims are invalid by saying the Stadtfeld disclaimer admitted the original claims 1, 2 and 3 were invalid; and by saying (pp. 17, 43) the cancellation of claims 3, 4, 5 and 8 admitted the disclaimer details were not new. Neither statement or assumption by appellant is true.

Just as appellant's argument (pp. 41-46) attempts to piece together the prior art, taking a little here and a little there, etc., to make up the Stadtfeld pipe, so, in this erroneous argument about the effect of the disclaimer and of cancelling claims, it attempts to piece together some law, made on the spot, and then to apply this to assumed facts.

An examination of the file wrapper (III. 694) shows that claims 1, 2 and 3 as originally granted were for the three elements,—the inner tube, the outer tube, the insulation, and the functional limitation of slidability. On the other hand it shows (III. 694, 698) that cancelled claims 3, 4, 5 and 8 never included the functional limitation of slidability and claim 8 in addition never included the third element, insulation. *Therefore, the allowed claims were never co-extensive with the cancelled claims.* By cancelling claims 3, 4, 5 and 8 Stadtfeld did not admit that the structure of those claims was old, but only that he did not choose to assert further his claim to them. Here is the first erroneous assumption by appellant's argument which is not supported by the law about the effect of cancelling claims:

“It is a declaration that that which is not claimed is either not the patentee's invention, or, if his, *he dedicates it to the public.*”

*Miller v. Bridgeport Brass Case*, 104 U. S. 350, 352.

In other words, *by cancelling a claim the patentee does not automatically manufacture prior art against the claims he does accept* (compare *Johnson v. Philad Co.*, 96 F. (2) 442, 444, 2nd column (C. C. A. 9) (appendix, p. x)). He does estop himself from ever contending that the claims he accepts are to be construed as broadly as those that were given up. *Appellant is free to make the two-element construction of claim 8 because Stadtfeld dedicated that to the public, but such a structure would not be marketable.* There is no rule of law to support appellant's unjust-



tified attempt to confuse the rule on estoppel just mentioned, with its erroneous assumption that a cancelled claim becomes prior art. It definitely does not, as Judge Learned Hand held in *United Chromium v. International*, 60 F. (2d) 913, 915 (C. C. A. 2):

“It is never for instance a good defense to a claim that it might have been broader; *the patentee need not at his peril claim all that he might; he does not concede that each element is necessary to avoid anticipation.* He may prove an invention broader than he claimed; the unnecessary elements introduced need not be themselves an invention. *Else it would be possible to invalidate any claim by showing that the patentee had yielded too much to the Examiner.*”

The other erroneous, unsupported assumption which appellant couples with the one just discussed is the same fundamental error which appears unsupported throughout appellant's brief to the effect that filing a disclaimer is an admission that the claims are invalid, therefore appellant says the original claims can be used as prior art. We have already cited two authorities (p. 51, *supra*) which show the correct rule of law is that filing a qualifying disclaimer of the Stadtfeld type, making the claim specific instead of generic, is very definitely not an admission of invalidity. An authority in addition to those already cited is *Manhattan v. Helios*, 135 F. 785, where the court ruled that the *disclaimed matter could not be used as prior art.* This clearly answers the unsupported contention of appellant:

“There is no admission, however, in this that the subject of the disclaimer appears in the prior art,

which may not by any means be the case, *nor is there any justification for so construing it*. It merely takes out of the patent the excided matter, leaving it as though it had never been there. This does not, of course, prevent that which is disclaimed from being identified with anything to be found in the prior art—such as the Spencer lamp, for instance, in the case in hand—with whatever argument may be legitimately drawn therefrom. But *there is no sanction for using the disclaimer as evidence that there is any such device in fact, which is the effect sought to be given it here, as to which it does not undertake to speak.*”

And as Judge Learned Hand said on this point in the *Chromium* case, 60 F. (2d) 913:

“There is no reason to impute to his caution a declaration about what the prior art actually contains.”

Also see *Bay State v. Klein*, 20 F. (2d) 915 where the court said:

“Defendants contend that the filing of the disclaimer constitutes an admission that the patent in suit, without disclaimer, would have been invalid. This contention, in my opinion, is erroneous (citing cases). This was not a disclaimer, where a claim or claims had been held invalid by a court.”

And *National Fruit v. Musselman*, 8 Fed. Supp. 994 (Pa.):

“The filing of a disclaimer is not an admission that the subject matter of the disclaimer appears in the prior art, and the patent therefore is not on that account invalid.”

And so we come to the end of examining the groundless attacks appellant makes on the trial court's validity and invention findings. *The record and appellant's own conduct show that Stadtfeld put together something that it can't get along without.* (See *Mohr v. Alliance*, 14 F. (2) 799, 800 (C. C. A. 9) top of 2nd column). Nowhere does the prior art contain that something. Clearly, Stadtfeld's mental concept of a new kind of twin-walled flue pipe comprising the three elements, inner and outer tube and insulation in between, with slidability, was of a patentable character and entirely new in the art. Appellant's brief scarcely denies this. The limiting disclaimer was prepared in exact conformity with those approved by the Supreme Court and other federal courts. These cases appellant ignores and attempts, without any supporting authorities, to place its own interpretation on the disclaimer statutes. On its false interpretation it bases a false premise which contaminates its whole brief. Certainly, there is no showing in appellant's brief that would warrant this Court in disturbing the findings of the court below. Appellant's whole conduct toward the invention places it in an unenviable position: first in failing to carry out its agreement with Stadtfeld, and then when the invention got into the strong hands of appellee, its competitor, of trying to buy the invention, and then, when refused, of stubbornly insisting on appropriating it on the possible chance of an inadvertent decision. Lest appellant itself focus attention on this additional unfavorable aspect of the case, it abandoned its alleged shopright or license defense (p. 4, line 6) and many other contentions advanced in the court below.

**CONCLUSION.**

This case presents an important invention for adjudication by this Court. The decree below is fully supported by the complete findings of the trial judge. These findings dispose of every contention advanced by appellant to this Court, and they are amply supported by the evidence. We submit that the decree below should be affirmed. The result will be to reward properly the making of a truly meritorious invention in accord with the purpose of the patent laws.

“If there be one central controlling purpose deducible from all these decisions, and many more that might be quoted, it is the steadfast determination of the court to protect and reward the man who has done something which has actually advanced the condition of mankind, something by which the work of the world is done better and more expeditiously than it was before.”

*Hallock v. Davison*, 107 F. 482, 486.

Respectfully submitted,

A. DONHAM OWEN,

*Attorney for Appellee.*

(APPENDIX FOLLOWS)





## Appendix

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### NON-ANALOGOUS PAPER PRIOR ART

The flue pipe prior art is discussed at page 72, supra. The following discussion relates to the non-analogous art which appellant has gathered together in desperation over the few patents it found in the flue pipe art.

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#### Two Patents Show Steam Pipe Covering Materials

Hammill No. 311,750 (Def. Ex. 4-A, III. 711)

Aldrich No. 340,691 (Def. Ex. 4-B, III. 714)

Covering for steam pipes as shown by these patents dates at least from 1885. As far back as any of us can remember we can recall seeing steam pipes wrapped with an asbestos coating and usually held around the pipe by metal straps. This can be seen in the basement of any building heated by steam. The problem in steam pipe covering is very different from a flue pipe and is to provide an insulating structure which can be placed around the steam pipe after the pipe is joined together and each joint is tested for leakage by a steam fitter.

Two forms of covering have been in general use, and are typified in the above patents. One form is shown in Fig. 2 of Hammill (Def. Ex. 4-A) where the insulating material is wrapped, layer on layer, around the pipe until the desired number of wrappings is obtained and then a covering of asbestos paper A' is secured around the outside. The other form is shown in Fig. 3 of this same

patent and comprises making up the insulating covering around a mandrel about the size of the steam pipe A and when completed it is slit longitudinally so that it can be spread open when installing it around the steam pipe, as it cannot be slid over the end.

Steam pipe coverings are not an analogous art to flue pipes. Operatively they have nothing in common. A flue pipe has the gases of combustion in contact with it. A steam pipe covering has no gases to convey. A flue pipe accumulates on its inner surface condensed moisture from these hot gases. A steam pipe covering does not have a moisture problem on the inside. A flue pipe like appellee's and appellant's must have two independent leak-proof jointed concentric strings of tubing to entrap the gases on the inside and protect the intervening asbestos from moisture coming from either the inside or outside. A steam pipe cover need do only one thing, namely, provide a layer of insulation around the steam pipe.

There is no problem, when covering a steam pipe, of installing the steam pipe and the covering, section by section, while one is within the other, therefore, relative slidability has never been a factor.

*It is perfectly obvious that steam pipe covering would not function as a flue pipe. Appellant offered no proof to show that it would and defendant's own letter exhibits chronicling some of Stadtfeld's early experiments at Waylands show that at one time he tried to make flue pipe substantially like steam pipe covering and it was a failure.*



A modified form of steam pipe covering is shown in *Aldrich*, 340,691 (Def. Ex. 4-B), having a felt packing inside two sheet metal plates I and B.

*We call the court's attention to the bolts L at each end of the drawing of Fig. 1, which extend between the two metal members I and B and positively prevent any slidability (patent p. 1, line 70).*

There is no need for slidability in *Aldrich*, for his steam pipe covering is made up in the flat at which time bolts L are put in. They hold the several layers against slidability. These flat assemblies are laid against the steam pipe and then bent around it and locked by the bolt M in band K (patent p. 1, lines 72 to 82).

*The tubes thus formed are not seamed and would not be gas tight, therefore, if any attempt were made to use the assembly as a flue the gas would leak out. The joints are both male on one end and both female on the other end. This would cause further leaks. This "steam pipe or boiler covering" would be absolutely useless as a flue pipe.*

Not one of these patents on steam pipe covers meets the claims in suit. The court can very quickly satisfy itself on this by turning to the claims and disclaimer (p. 19, *supra*).

#### **One Patent Shows a Thimble**

Meade, No. 1,428,294 (Def. Ex. 4-F, III. 730)

Meade shows a stove pipe thimble and is the next of the patents to be considered. Appellant's comments on

this patent (pp. 42, 44) are of no value whatsoever, and at page 44, line 18, contain a positive misrepresentation that this reference shows male and female fittings.

A thimble is a device used to space a flue pipe or stove pipe away from cumbustible portions of a dwelling structure. *It is not a flue pipe as it does not convey any gases of combustion.*

The stove pipe is shown in dotted lines in Fig. 1 of the patent. Appellee made up two scale models of the device (Pl. Ex. 22-A, 22-B) to show that they could not be used to convey gases. *One object in a thimble is to allow as much cooling as possible of the inner pipe, hence the air space between the pairs of cylinders 13 and 12 (see Fig. 2). This is opposite to the purpose of the patent in suit which fills the space between the tubes with insulation to prevent cooling of the inner tube.*

Meade has no male and female ends on the tubes arranged to shed moisture condensing on the inside or falling on the outside. *Meade lacks any way of connecting together a series of inner tubes and of outer tubes.*

#### One Patent Shows an Underground Conduit

Harvey No. 534,473 (Def. Ex. 4-D, III. 722)

Just what relationship an underground conduit has to a flue pipe appellant nowhere explains. Appellant cites no authorities to show it is an analogous art. The problems certainly are not those in the flue pipe art.

We submit that one glance at the patent is enough to show its complete lack of disclosure and the utterly frivolous contention of appellant.

*Appellee's witness testified without contradiction that Harvey was not suitable as a flue pipe (II. 566) and that it would be impossible to erect. Another drawback is that the terra cotta pipe shown, if used for a gas flue, would not be efficient and would cause "condensing of the gases quicker than anything else" (II. 568).*

*Appellant furthermore made no effort to establish that it would operate like the patent in suit and the authorities (Las Alamos v. Carroll, 173 Fed. 280, 284, C. C. A. 9) show such identity must be established.*

#### **One Patent Shows a Waterpipe**

Welch No. 1,927,105 (Def. Ex. 4-G, III. 735)

This patent for a water-pipe cannot be said to be in the flue pipe art. Aside from this there is a complete failure of disclosure of a structure which could serve as a flue pipe. Appellant made no effort to show it could be so used.

Appellant, apparently embarrassed by the remoteness of this patent, seeks to dismiss it without particular comment beyond the conclusion that it is "anticipatory" (p. 41).

#### **Four Patents Show Hot Air Pipe**

O'Toole No. 878,014 (Def. Ex. 4-E, III. 726)

Bradbeer No. 390,438 (Def. Ex. 6-A, III. 780)

Line No. 690,744 (Def. Ex. 6-C, III. 787)

Line No. 696,059 (Def. Ex. 6-D, III. 790)

*The object in hot air pipe is to convey hot dry pure air from a furnace in the cellar directly into the rooms to be*

*heated.* Installations are inside of dwelling walls shielded from outside moisture. Thus, *there is no moisture problem*, either inside or outside the pipe and *it makes no difference what kind of connections are made between the sections of pipe.* Nor is it essential that these connections be gas tight since the air is pure and not poisonous products of combustion. *Lacking any of the problems encountered in the flue pipe, it is clear why neither O'Toole, Bradbeer, nor Line discloses any concept of a flue pipe like the one in suit. They are in a different art.*

A year before Stadtfeld applied for his patent, appellant's then patent attorney, Connor, distinguished the Stadtfeld invention from O'Toole and Line and said they should not stand in the way of securing a patent for Stadtfeld (III. 884).

To adapt or reconstruct the O'Toole device to the purposes of its argument, appellant *has changed* the inner tube 2 to a seamed tube and *omitted the rivets* 4. Appellant *then proposes* to have the sections supported one on top of the other, whereas the patent shows them spaced apart at each joint. Even with all of these changes O'Toole does not have a superficial resemblance to the device in suit. Furthermore, *none of these changes is described or suggested in the O'Toole patent.*

No one thought of making these changes before appellant's counsel made them.

*Appellee's and Appellant's witnesses agree that as a flue pipe O'Toole would disqualify because moisture entering at the open joints "would soon destroy its insu-*

*lating value''* (II. 168, 372, 563). Appellant made no effort to overcome appellee's proof that the *O'Toole patent was impractical for a flue pipe*. If Appellant asserts it is the same thing, which inspection alone discloses is not true, it was appellant's burden to show it by test.

Reliance on such patents as these only discloses the desperation of appellant's case.

*The Bradbeer patent* was a file wrapper reference and appellant *proposes to reconstruct* it by taking it all apart and reversing the inner and outer pipes so as to get the male and female ends of the tubes adjacent. *Appellant overlooks several significant things*. First, none of this reconstruction is suggested by Bradbeer, who invented a hot air pipe where moisture and joints are not a problem. Second, the coupling members a<sup>3</sup> of Bradbeer won't function with such a rearrangement. Third, Bradbeer lacks the element of insulation between the tubes. Fourth, Bradbeer lacks slidability.

*The Line patents* are even more remote.

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SEC. 4917. (U. S. C., TITLE 35, SEC. 65.)

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent *shall be valid for all that part which is truly and justly his own*, provided the same *is a material or substantial part of the thing patented*; and any such patentee, his heirs or as-

signs, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, *make disclaimer of such parts* of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

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**SEC. 4922. (U. S. C., TITLE 35, SEC. 71.)**

Whenever, through inadvertence, accident, or mistake, and without any willful default, or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding

the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.

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**JOHNSON v. PHILAD, 96 F.(2d) 442, 445.**

“Validity of Reissue Claims 3, 4, 5, and 6.

Appellant contends that claims 3, 4, and 5 are invalid because reissue claims attempting to recover claim 1 of the original patent (1,622,957) which was rejected by the Patent Office.

(5) This question was considered by Judge Byers in *Philad Co. v. Rader*, D. C., 15 F. Supp. 509. He there pointed out the fact that the claims in the reissued patent were narrower than claim 1 which was rejected upon the first application for the patent. He pointed out that the new claims all were confined to the use of the process in waving hair upon the human head; that the clamps described were restricted to those which gripped and that the nature of the covering applied to the roll during heating was specifically described in the new claims, while in the rejected claim it was referred to generally as ‘applying covering members to the roll of hair.’ These claims (3, 4 and 5) of the reissued patent were clearly narrower than the rejected claim 1.

The patentee was not estopped from making these narrower claims, particularly because the claim 1 was rejected upon the patent to Szlanyi, No. 1,400,637, which did not show a method of gripping the hair next the scalp, but did show a pad next the scalp containing a slot through which the strand of hair passed. See *John W. Gottschalk Mfg. Co. v. Springfield Wire & T. Co.*, 1 Cir., 74 F. (2d) 583.

However, in view of the prior art patents to Popin, No. 1,447,997, and to Szlanyi, No. 1,400,637, the word 'clamp' used in defining the first step of the process described in claim 4 should be construed to cover only a clamp having a gripping action."

pp. 444, 445

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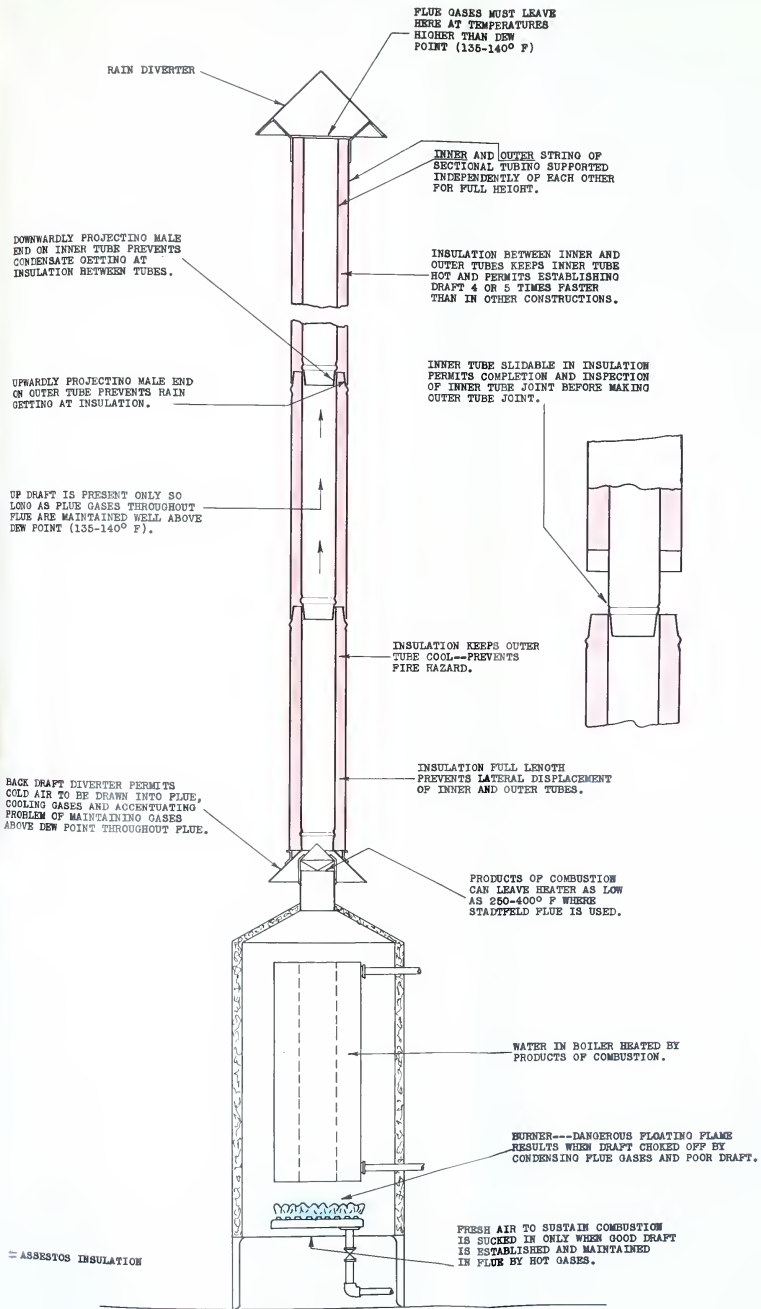
**SIMONS v. DAVIDSON BRICK CO., 106 F.(2d) 518, 521 (C.C.A. 9)**

"It is true that the appellant, after paying apparent attention to the rule of court requiring specifications in a brief, completely ignores the rule and discusses the whole problem without regard to the specific findings of the trial court or any claim of error in specific findings. \* \* \*

"Our rule should be followed. It is necessary as far as possible to sharply define the contentions of the appellant, and to avoid the difficulties arising from haphazard contentions upon questions of law and fact that may or may not be germane to the questions raised by the appeal.

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TYPICAL STADTFELD INSTALLATION

